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Request for Reconsideration after Final Action

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ARGUMENT(S)	
<p>This responds to the Office Action dated August 12, 2008.</p> <p>The Examining Attorney has maintained – and made final – his refusal on the grounds that the specimen submitted at the time of filing does not match the drawing of the mark, and that Applicant must submit a new specimen. 37 C.F.R. §2.51(a); <i>see</i> 37 C.F.R. §2.72(a)(1).</p> <p>Applicant continues to disagree with the Examining Attorney. Accordingly, Applicant submits this Request for Reconsideration.</p> <p>Applicant fully incorporates by reference the arguments made in and evidence submitted with its July 21, 2008 Response to Office Action. To the extent necessary, Applicant may specifically make those arguments again or supplement them herein.</p> <p>First, the Examining Attorney has ignored and, in fact, has not even addressed Applicant's argument that "in a §1 application, an applicant has some latitude in selecting the mark it wants to register. <i>The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.</i>" Emphasis added. TMEP § 807.12(d).</p> <p>To the extent that "an applicant has some latitude in selecting the mark it wants to register," this would suggest that the burden is on the U.S. Patent & Trademark Office to establish that the elements of a specimen are "inseparable for registration purposes." The Board's decision in <i>In re Green U.O.D., Inc.</i>, Serial No. 76615858, (TTAB March 31, 2008) confirms that the burden is the Examining Attorney's. In that decision, the Board wrote: "Nonetheless, we find that there is at least some doubt involved, and that it is appropriate to resolve such doubt in applicant's favor." Applicant submits that the Examining Attorney has not met this burden. Since the latitude is Applicant's – not the Examining Attorney's – the specimen that Applicant</p>	

selected should be accepted. To the extent that, at the very least, Applicant has shown that doubt exists, such doubt should be resolved in Applicant's favor.

In its July 21, 2008 response, Applicant argued that: 1) "Every Age. Every Stage. Every Day." presents "a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen," TMEP § 807.12(a), and **CETAPHIL** with the background design creates its own commercial impression apart from the slogan; 2) the slogan is severable from **CETAPHIL** and the background design; and 3) that **CETAPHIL** is a recognized umbrella mark of Applicant.

The Examining Attorney rejected Applicant's arguments.
CETAPHIL is Applicant's House Mark

With regard to Applicant's argument that **CETAPHIL** is a recognized umbrella mark for a full line of products offered by Applicant, the Examining Attorney rejects this outright with no explanation. He writes: "the argument that **CETAPHIL** is a separately recognized umbrella mark owned by applicant is not persuasive because it has no bearing on the specimen issue in this case." The Examining Attorney offers no evidentiary, statutory or case law support for this proposition. However, he does incorporate the U.S. Patent & Trademark Office's "catch-all" argument that "[p]rior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994)." Applicant is not sure why this language was included. It seems wholly irrelevant to the Examining Attorney's argument, especially since Applicant made no arguments based on earlier decisions of other Examining Attorneys.

However, the Examining Attorney inappropriately dismisses this argument out of hand. Since the specimen label contains Applicant's umbrella mark **CETAPHIL** and Applicant's umbrella mark **CETAPHIL** is included on the drawing, it is indeed relevant. See **EXHIBIT A**. The Examining Attorney may not simply dismiss an argument as irrelevant to avoid addressing the substantive merit of the argument. TMEP § 713.03 ("When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney should respond to the applicant's arguments."). Applicant submits that the Examining Attorney's dismissal of Applicant's argument as irrelevant fails to meet the requirement that the Examining Attorney "respond to the applicant's arguments."

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01 (c)(ii).

Since Applicant has been using its **CETAPHIL** mark in commerce since at least as early as 1950 – for almost 60 years – it is obvious that a "word" portion which has been on the market

for 60 years and is presented in a font size which is more than 300% larger than the other words in the label, that element of the mark is “more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services”. Therefore, the fact that the **CETAPHIL** umbrella mark has been in use for more than 60 years and appears in a font size which is 300% larger than the other words on the label makes the fact that **CETAPHIL** is a well-known mark makes this argument very relevant.

Having been on the market continuously for nearly 60 years, Applicant’s mark is known to the public. Since § 2(f) acquired distinctiveness is *presumed* by the U.S. Patent & Trademark Office after only five (5) years of use, after 60 years of use, Applicant’s mark is known – if not famous – to the purchasing public.

Cases have frequently held that an applicant’s use of its corporate name or its house mark along with another trademark does not create a unitary mark. *See, e.g., In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) (“The courts in a proper case may recognize the right to registration of one part of an owner’s mark consisting of two parts.”); *Textron Inc. v. Cardinal Engineering Corp.*, 164 USPQ 397, 399 (TTAB 1969) (“While the record does not show that Textron’s principal or house mark ‘HOMELITE’ appears on its chain saw as well as in all of its advertising literature, there is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin”); *In re Emco, Inc.*, 158 USPQ 622, 623 (TTAB 1968) (“It is concluded that the law and the record support applicant’s position that ‘RESPONER’ is registrable without addition of the surname ‘MEYER’”); and *In re Barry Wright Corp.*, 155 USPQ 671, 672 (TTAB 1967) (“It is clear that the notation ‘8-48’ stands out as a distinguishable element separate and apart from the statement ‘ANOTHER 8-48 FROM MATHATRONICS’”).

Even when terms have been physically joined in the specimens, case law recognizes that these terms can be separately registered if the evidence of record indicates that they will be recognized as distinct trademarks. *See In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (Holding that “the fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented by this case, create a unitary expression such that ‘TINEL-LOCK’ has no significance by itself as a trademark”); *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969) (GRIPLET creates a separate commercial impression despite overlapping with house mark BERG); *In re Dempster Brothers, Inc.*, 132 USPQ 300 (TTAB 1961) (Despite specimens showing the terms DEMPSTER DUMPMAS^{TER} sharing the first and last letters, DUMPMAS^{TER} separately registrable).

The Board specifically addressed this issue in *In re Royal BodyCare, Inc.*, ___ USPQ2d ___, Serial. No. 78976265 (TTAB Feb. 22, 2007), which was discussed in Applicant’s July 21 Response. In that case, the Board reversed the refusal to register the term “NANOCEUTICAL,” finding that the term is actually used in a manner that creates a commercial impression separate and apart from the house mark or trade name “RBC’s,” where the mark appears as **RBC’S NANOCEUTICAL**.

Without addressing this decision or Applicant’s arguments based on that decision, the Examining Attorney concluded that the fact that **CETAPHIL** is an umbrella mark is irrelevant despite the obvious relevance as discussed in binding precedent.

The published, citable decisions of the Board make clear that the fact that Applicant's CETAPHIL mark is a well-known umbrella or house mark for a range of its products is in fact relevant. In light of this obvious precedent which is available to the Examining Attorney as a record of the U.S. Patent & Trademark Office, his conclusion that "the argument that CETAPHIL is a separately recognized umbrella mark owned by applicant is not persuasive because it has no bearing on the specimen issue in this case" is clearly erroneous. It is relevant and the Examining Attorney must consider it since the cases cited above are cited for their legal precedence – not the similarity of factual issues.

The Standard of Review: Overall Commercial Impression

Whatever elements might be considered in determining whether the specimen is a substantially exact representation of the mark as shown in the drawing, the overall commercial impression remains controlling. *In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), citing *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983); *In re In Mook Kim* Serial No. 78483075, (TTAB July 14, 2006); *In re The Gray Foxes*, Serial No. 76544022, (TTAB September 30, 2005).

It is clear that when a consumer or prospective purchaser sees this mark on the shelf, she will be able to discern two (2) primary elements: the CETAPHIL umbrella mark and Applicant's overlapping ellipses logo. A consumer would not be able to read the "Every Age. Every Stage. Every Day." element of the label on a store shelf. Applicant's position is supported by the photograph annexed hereto as EXHIBIT B, which shows Applicant's actual products on an actual store shelf. Applicant directs the Examining Attorney's attention to the fact that the background logo and CETAPHIL are legible; however, the "Every Age. Every Stage. Every Day." slogan is unreadable from a normal shopping distance.

"[T]he shape and two-tone pattern would be discernible from a distance, even though the writing on the design would not be. Due to this manner of use, consumers would identify applicant's golf clubs by the design alone. This also supports the conclusion that the design creates a separate commercial impression." *In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), citing *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983) ("At a distance the words may be hard to read but the design stands out and provides a means of ready recognition"). In the instant case, "the shape and two-tone pattern would be discernible from a distance, even though the writing [Every Age. Every Stage. Every Day.] on the design would not be. Due to this manner of use, consumers would identify applicant's [dermatological products] by the design [and house mark]. This also supports the conclusion that the design creates a separate commercial impression." Applying this legal standard to the facts of the instant case, "[a]t a distance the words [Every Age. Every Stage. Every Day.] may be hard to read but the design [and house mark] stand[] out and provide[] a means of ready recognition."

Again, the inclusion of Applicant's umbrella mark in a large font size is important to the analysis, despite the Examining Attorney's cavalier and erroneous dismissal of these facts. Not only is it relevant, according to the decisions of the Board mentioned above, it strongly favors withdrawal of the Examining Attorney's refusal.

Viewed from a consumer's or prospective consumer's perspective, from a distance while shopping, the commercial impressions made by the drawing and the mark are the same. This analysis has been specifically accepted by the Board. *See In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), *citing In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983).

Based on this representation of the mark, it is clear that **CETAPHIL** and the background logo are severable from the "Every Age. Every Stage. Every Day." element. It also demonstrates the importance of the fact that **CETAPHIL** is a well-known umbrella mark for Applicant's goods.

"[J]udicial notice may be taken of the fact that it is a common practice for manufacturers to apply both a house mark and a product mark to their various items of merchandise." *Textron Inc. v. Cardinal Engineering Corp.*, 164 USPQ 397, 399 (TTAB 1969). Inasmuch as "judicial notice may be taken of the fact that it is a common practice for manufacturers to apply both a house mark [or umbrella mark] and a product mark to their various items of merchandise," the Examining Attorney may not dismiss the relevance of the fact the **CETAPHIL** is a well-known umbrella mark.

The Examining Attorney argues that "Every Age. Every Stage. Every Day." is not severable from the mark as depicted in the drawing because:

the elements **CETAPHIL** and **EVERY AGE. EVERY STAGE. EVERY DAY** slogan on the specimen label is contained within the inner design in extremely close proximity; in fact, the P in **CETAPHIL** dissects the slogan between **EVERY STAGE** and **EVERY DAY**. Thus, the commercial impression created by the specimen is that the term **CETAPHIL** and the slogan **EVERY AGE. EVERY STAGE. EVERY DAY** is inextricably linked. In addition to the extremely close proximity and placement within the label design, the slogan is part and parcel of the mark on the specimen because it explains suggestive usage of **CETAPHIL**. The slogan does not stand apart from **CETAPHIL** by physical separation or unrelatedness of the meaning of the slogan. The fact that the slogan is in a smaller font and color than **CETAPHIL** only serves to show the slogan is meant as an explanatory modifier of the use of **CETAPHIL**. Thus, the mark and slogan are not separable elements in this case.

The Examining Attorney's argument that the "P" in **CETAPHIL** dissects the slogan between **EVERY STAGE** and **EVERY DAY** is not on point. **EXHIBIT C** contains definitions of the word "dissect". By and large, every definition of "dissect" is conceptually the same: "To cut apart or separate body tissues or organs, especially for anatomical study". The very word chosen by the Examining Attorney – "dissect" – implies that **CETAPHIL** and "Every Age. Every Stage. Every Day." are distinct, severable elements. A thing does not typically dissect itself. The word "dissect" implies that one separate thing is acting on something else. Thus, contrary to the Examining Attorney's conclusion, dissection does not mean that the elements are "inextricably linked;" it means they are separate elements. Therefore, at most, this argument does nothing more than reiterate the fact that **CETAPHIL** and "Every Age. Every Stage. Every Day." are physically close to each other. This argument adds nothing to the Examining Attorney's overall argument. Contrasting the meaning of "dissect" with the

meanings of “intertwined,” “merged,” and “interwoven,” the Examining Attorney’s position is weak.

In *In re Alchemy Nominees Pty LTD*, Serial No. 75/501,743, (TTAB July 22, 2003), the Board concluded, “[i]n this case, we acknowledge that the spatial placement and *overlapping* physical relationship of the wording ‘Decking Excellence’ (*i.e.*, underlining the word ‘Deck’ and covering up a portion of the word ‘One’) create some degree of physical connectedness between the literal elements of the composite mark shown on the specimen. On the other hand, we do not agree with the Trademark Examining Attorney that the word “Decking Excellence” is an inseparable element of the entire mark as shown on the specimens. Rather, we find that visually the laudatory term ‘Decking Excellence’ comprises and incidental overlay. As to connotation, the wording ‘Decking Excellence’ merely accentuates the ‘preeminent’ connotation of ‘Deck One.’”

In that same opinion, the Board concluded that, “Finally, the unique design of the critical components of the mark remain unchanged between these two presentations, leaving the overall commercial impression of the DECK ONE mark unchanged with this addition....”

EXHIBIT D includes the drawing and the specimen at issue in *In re Alchemy Nominees Pty LTD*.

Indeed, in *In re Alchemy Nominees Pty LTD* (Serial No. 75/501,743, July 22, 2003), the Examining Attorney described “the new wording element on the specimen as being ‘merged,’ ‘intertwined’ or ‘interwoven’ with DECK ONE.” Despite the Examining Attorney’s conceptualization of the additional matter being “merged,” “intertwined” or “interwoven” with the mark as shown on the drawing, the Board reversed the refusal. Here, the Examining Attorney concludes that the additional matter is dissected by another element of the label. “Dissect” imparts a very different meaning than “merge,” “intertwine,” or “interweave”. If the best that the Examining Attorney can conclude is that one element “dissects” the other element, it is impossible to conclude that those elements are not severable. For definitions of these words, see EXHIBIT E.

Contrary to *In re Alchemy Nominees Pty LTD* where there was actual “overlap,” Applicant’s mark here does not overlap with the CETAPHIL element. More importantly, here, like in *In re Alchemy Nominees Pty LTD*, “the unique design of the critical components of the mark remain unchanged between these two presentations, leaving the overall commercial impression of the [CETAPHIL & Design] mark unchanged with this addition....” This conclusion is confirmed by the fact that, from a distance, the label and the drawing create the same commercial impression.

Proximity of Elements

In the instant case, the Examining Attorney focuses on the fact that the elements are in close proximity. However, he places unjustified reliance on this one factor. He ignores that the font styles are different (standard vs. italicized) and the size difference between the elements is enormous. This is reinforced by Applicant’s specimen photograph in which “Every Age. Every Stage. Every Day.” is barely readable or discernable from a “normal” shopping distance.

In re Karsten Manufacturing Corp., Serial No. 78347910, (TTAB September 12, 2005), *citing In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983) (“At a distance the words may be hard to read but the design stands out and provides a means of ready recognition.”). Indeed, two (2) of the three (3) factors considered by the Board in *In re Big Pig* weigh in favor of Applicant. Since the Examining Attorney has not established that the proximity factor is in any way more important or more relevant than the font size, font style factors or the fact that the elements appear on different lines, the Examining Attorney’s exclusive reliance on the proximity of the elements is short-sighted.

The Board has, time and again, restated that proximity is not the deciding factor. “Contrary to the examining attorney’s apparent contention, the mere fact that two or more elements of a composite mark are in close proximity to each other does not necessarily mean that those elements cannot be registered separately. Proximity is a consideration but it is not the only consideration. It is the overall commercial impression that is controlling.” *In re The Gray Foxes*, Serial No. 76544022, (TTAB September 30, 2005).

Mere proximity “does not endow the whole a single, integrated, and distinct commercial impression.” *Dena Corp. v. Belvedere International Inc.*, 960 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

“The fact that the wording is in close proximity to the graphic elements does not dictate that those elements cannot be registered separately. While proximity is a consideration, it is the overall commercial impression of the mark that is controlling.” *In re In Mook Kim* Serial No. 78483075, (TTAB July 14, 2006).

The Examining Attorney also makes the argument that “the slogan is part and parcel of the mark on the specimen because it explains suggestive usage of CETAPHIL. The slogan does not stand apart from CETAPHIL by physical separation or unrelatedness of the meaning of the slogan.” Applicant is unsure of what this means. “Because it explains suggestive usage of CETAPHIL” is so vague so as to be unhelpful. Similarly, “unrelatedness of the meaning of the slogan” is ill-explained.

For purposes of this argument, Applicant assumes that the Examining Attorney is somehow suggesting that that the slogan is the equivalent of “Directions for use”. That is an irrelevant argument. First, the slogan is not directions. The back of the product includes “Directions For Use Without Water” and “Directions For Use With Water”. See EXHIBIT F. No consumer would confuse the “Every Age. Every Stage. Every Day.” with directions for use of the product. If the slogan functioned as the Examining Attorney suggests, that element would be considered merely descriptive under § 2(e)(1). The Examining Attorney has issued no such refusal.

Further, Applicant submits that the slogan is “suggestive” of how to use the product is non-sensical. “Suggestive use” is a notion fabricated by the Examining Attorney with no relevant meaning to trademark analysis. No reasonable person would conclude that “Every Age. Every Stage. Every Day.” is intended as or suggests directions as how to use the product. Even if the Examining Attorney is correct and the slogan does function in that manner, it directs users how to use the product – which means it is not inextricably linked to the mark. As the Examining

Attorney well knows:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a *bona fide* intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127

Since a trademark distinguishes one’s products from those of others *and* indicates the source of goods, the explanation of “suggestive usage” (to use the Examining Attorney’s words) explains use of the product – not the trademark.

This means that (1) the slogan refers to the product rather than the mark and (2) by consequence, it means that the slogan is severable from the remainder of the mark. If the language, as the Examining Attorney contends, suggests how to use the product, then its suggestive nature renders it severable from the remainder of the mark.

Accepting, *arguendo*, the Examining Attorney’s assessment of the slogan as “suggestive [of] usage,” this conclusion is not determinative. For example, in *In re Pharma Cosmetix Research, supra*, the Board concluded that “EPF is obviously an abbreviation for the phrase ENVIRONMENTAL PROTECTION FACTOR. However, the phrase also has its own meaning, apart from the abbreviation. *See, e.g., Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1043 (TTAB 1985) (noting that although the pictorial representation of Pegasus, ‘may reinforce the word [Pegasus],’ the word also created its own separate commercial impression).”

Similarly, in *In re Alchemy Nominees Pty LTD, supra*, the Board concluded: “Rather, we find that visually the laudatory term ‘Decking Excellence’ comprises an incidental overlay. As to connotation, the wording ‘Decking Excellence’ merely accentuates the ‘preeminent’ connotation of ‘Deck One.’”

The Board’s assessment of these elements as an abbreviation or accentuation is essentially the same assessment as the Examining Attorney’s assessment that the slogan represents “suggestive usage” or “relatedness of the meaning of the slogan”. These conclusions are not determinative. In both *In re Pharma Cosmetix Research* and *In re Alchemy Nominees Pty LTD*, the material not included in the drawing was somehow related to or explanatory of the other elements of the mark. Nonetheless, the Board concluded that those elements created different commercial impressions. So, too, the Examining Attorney should conclude that “Every Age. Every Stage. Every Day.” creates a different distinct commercial impression and should withdraw his refusal.

Moreover, a “component does not need to create the dominant commercial impression in the composite mark in order to be registrable, it only has to create a separate commercial

impression.” *In re Pharma Cosmetic Research, L.L.C.*, Serial No. 76269152 (TTAB October 11, 2007).

A Relevant Example

In addition to the cases discussed by Applicant above and in its July 21 ROA, Applicant directs the Examining Attorney’s attention to Registration No. 3071013 (Application Serial No. 78598517) for the mark **CITRUCEL & Design** for *laxatives and dietary fiber supplements* in Class 5. The drawing filed in connection with Application Serial No. 78598517 and the specimen submitted therewith are annexed hereto as **EXHIBIT G**.

The specimen which was submitted – and accepted with no objection.

In the case of Registration No. 3071013, the specimen contains elements which are not included in the drawing. Specifically, it includes “Methylcellulose Fiber Therapy for Regularity” directly below **CITRUCEL**.

Additionally, it includes the following phrases in the orange graphic:

- No Excess Gas
- Doctor Recommended
- 100% Soluble Fiber
- Easy to Swallow
- 100 Fiber Caplets

Applicant directs the Examining Attorney’s attention to the fact that “Methylcellulose Fiber Therapy for Regularity” appears in the same color and in close proximity to the much larger **CITRUCEL** element. Also, the phrases “No Excess Gas,” “Doctor Recommended,” “100% Soluble Fiber,” “Easy to Swallow,” and “100 Fiber Caplets” appear “within the inner design” and in the same yellow color which rings the orange graphic.

Applicant submits that the phrase “Methylcellulose Fiber Therapy for Regularity” appears at least as close to **CITRUCEL** as “Every Age. Every Age. Every Stage.” appears to **CETAPHIL**. Moreover, since both **CITRUCEL** and “Methylcellulose Fiber Therapy for Regularity” appear in the same color green (which is more unique and source-identifying than white), they – under the Examining Attorney’s analysis – are linked.

Since the phrases “No Excess Gas,” “Doctor Recommended,” “100% Soluble Fiber,” “Easy to Swallow,” and “100 Fiber Caplets” appear “within the inner design” and in the same yellow color which rings the orange graphic, a closer association between these elements and the design exists than exists in the instant mark. Yet, no refusal issued.

Additionally, the phrases “No Excess Gas,” “Doctor Recommended,” “100% Soluble Fiber,” “Easy to Swallow,” and “100 Fiber Caplets” appear “within the inner design,” and “Methylcellulose Fiber Therapy for Regularity” is “suggestive of usage” of the mark. It tells the consumer what the product is used for. This is the same analysis the Examining Attorney applied to the instant application when he states that the slogan is “suggestive” of use. Yet, no

refusal issued.

Applicant informs the Examining Attorney that Registration No. 3071013 issued in 2005. Applicant submits that there has been no change to trademark law, no change to the TMEP, no case law and no congressional statutory change which warrants different treatment of the instant mark from that covered by Registration No. 3071013. Therefore, the Examining Attorney should accept the instant specimen and withdraw the remaining refusal/requirement.

With regard to Registration No. 3071013, the specimen contained at least 19 additional words or terms not included in the drawing. By contrast, in the instant application, the specimen contains a mere six (6) additional terms. Therefore, if the CITRUCEL specimen qualified as a “substantially exact representation of the mark,” the instant specimen should qualify as a “substantially exact representation of the mark.”

While the Examining Attorney will argue he is not bound by the Examining Attorney’s decision in Registration No. 3071013, Applicant is not making that argument. Rather, Applicant submits this information as evidence as to how a proper examination of specimens should be undertaken. While the Examining Attorney may not be bound by the earlier Examining Attorney’s decision, Applicant submits that the Examining Attorney’s treatment of the specimens in Registration No. 3071013 follows the law and precedent – whereas the Examining Attorney in the instant case has deviated from proper analysis. In other words, the Examining Attorney for Reg. No. 3071013 applying the appropriate standard. The Examining Attorney in this case is not.

Next, the Examining Attorney argues that because of “the extremely close proximity and placement within the label design, the slogan is part and parcel of the mark on the specimen because it explains suggestive usage of CETAPHIL”. Accepting, *arguendo*, the Examining Attorney’s argument, the proximity of the elements is only one factor to be considered. *In re Jordan Outdoor Enterprises, Ltd.* (Serial No. 78298898, August 9, 2006) (“Contrary to the examining attorney’s contention, the mere fact that two or more elements of a composite mark are in close proximity to each other does not necessarily mean that those elements cannot be registered separately. Proximity is a consideration, but it is the overall commercial impression of the mark that is controlling.”). In *In re Big Pig, Inc.*, 81 USPQ2d 1436 (TTAB 2006), the Board considered “the word ... is displayed in a different color, type style, and size such that it stands out from the remaining words and design element”. In *In re Big Pig, Inc.*, despite the proximity of the elements of the mark, the Board concluded that the elements were severable. Moreover, in that case, the applicant argued that “[t]he other elements clearly form the background.”

Applicant is mindful that the U.S. Patent & Trademark Office takes the position that Examining Attorneys are not bound by the decisions of other Examining Attorneys. Nonetheless, a potential applicant, when making its determination whether a proposed mark is registerable, is entitled to a certain degree of reliance on the U.S. Patent & Trademark Office’s treatment of similar marks. This position is embraced by the Federal Circuit and the Trademark Trial & Appeal Board. The Court of Appeals for the Federal Circuit, in *In re Merrill, Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q. 2d 1141, 1144 (Fed. Cir. 1987), specifically held that the analysis of whether a mark is descriptive is to be

undertaken “in accordance with practice and precedent.” Furthermore, as stated by the Board in *In re Consol. Cigar*, 35 U.S.P.Q. 2d 1290, 1295 (T.T.A.B. 1995), “uniform treatment under the Trademark Act is desirable. . .” Also, “the Office strives for consistency”. *In re Sun Microsystems, Inc.*, Serial No. 75/430,476, (TTAB March 9, 2001). Inasmuch as uniform treatment is desirable, to the extent that an Examining Attorney wishes to use the argument that he is not bound by the decisions of other Examining Attorneys, the Board’s admonition that uniform treatment is desirable and that federal agencies must engage in reasoned decision making must be interpreted as meaning Examining Attorneys may not simply dismiss earlier decisions *without reason* other than he is not bound by earlier decisions. The Examining Attorney must offer some explanation: a change in law, a misapplication of law in the earlier decision or other error, a factual distinction, a change in the public’s understanding of a term, etc. However, not being bound by an earlier decision – alone – is not a justification for refusal. If the Office “strives for consistency,” an inconsistent decision must be explained. Here, the Examining Attorney has offered nothing other than the U.S. Patent & Trademark Office’s “get out of jail free card” of “Examining Attorneys are not bound by the decisions of other Examining Attorneys.”

While it may be the position of the U.S. Patent & Trademark Office that the Examining Attorney is not *bound* by the decisions of other Examining Attorneys, the examples above clearly show how the U.S. Patent & Trademark Office and other Examining Attorneys have treated nearly identical (or at least similar) situations. In light of the acceptance of the specimens in connection with Registration No. 3071013 and the Board’s decision in *In re Big Pig, Inc.*, it is clear that the Examining Attorney’s analysis is incorrect and contravenes the position of the U.S. Patent & Trademark Office.

Moreover, the cases offered by the Examining Attorney are not on point to the facts of this case. For example, *AMF Inc. v. Am. Leisure Prods., Inc.* stands for the proposition that the existence of third party registrations does not mean that another confusingly similar mark should be registered. Additionally, when doubt exists as to a § 2(d) refusal, doubt must be resolved in favor of the prior registrant. In this case, there is no § 2(d) refusal and since an applicant is entitled to discretion in determining what its mark is, this decision is not controlling.

With regard to *In re Int’l Taste, Inc.*, that decision involved a situation where several registered marks in which the word “Hollywood” is disclaimed and two registrations with no disclaimer of the term “Hollywood.” In that case, the Office treated the word “Hollywood” inconsistently. Despite this fact, the Board wrote, “while the Office strives for consistency, the Board must decide each case on its own facts and record.” Again, the Board noted the importance of consistency. Moreover, in this case, the Board *reversed* the Examining Attorney’s decision and decided in favor of the applicant. In that case, consistency led to a decision favorable to the applicant.

With regard to *In re Sunmarks, Inc.*, the Board held that the Board is not bound by the decisions of other Examining Attorneys. Moreover, *In re Sunmarks* involved a likelihood of confusion issue when the applicant sought to obtain a second or subsequent registration of **ULTRA** for an expanded list of goods from its first registration. In the instant case, there is no likelihood of confusion issue. Applicant is not seeking a second registration. *In re Sunmarks*

also stands for the proposition that when doubt exists as to a § 2(d) refusal, doubt must be resolved in favor of the prior registrant. However, as *In re Green U.O.D., Inc.*, *supra*, makes clear, doubt as to the severability of elements of a mark should be resolved in Applicant's favor. Since an applicant is entitled to discretion in determining what its mark is, this decision is not controlling.

None of these cases are directly on point and none stands for the sweeping proposition that Examining Attorneys may arbitrarily refuse registration with impunity and hide behind the provision of TMEP § 1216.01. In each of those cases, there was some valid basis to distinguish the case at issue from the prior decisions.

While the Examining Attorney has focused [incorrectly] on the proximity of the "Every Age. Every Stage. Every Day.," it must be remembered that the overall commercial impression is controlling. In *In re Alchemy Nominees Pty LTD*, the Board found it "helpful" to review decisions in which the applied-for element were in fact found to be "inextricably bound together". EXHIBIT H shows the drawings and the specimens in these cases, and includes the *In re Alchemy Nominees Pty LTD* decision.

Inasmuch as the Board found it helpful to review cases in which the elements of the marks were not severable, Applicant believes that it is equally instructive to review those cases when the Board concluded that the elements of marks were severable and created distinct commercial impressions. EXHIBIT I shows the drawings and the specimens in these cases. The marks identified in EXHIBIT I are more similar to the instant mark than those identified by the Examining Attorney or those in EXHIBIT H.

Using the ultimate test which is the "the overall commercial impression," Applicant submits that the CETAPHIL and the background logo create a distinct commercial impression from the "Every Age. Every Stage. Every Day." slogan. This conclusion is supported by the history of the Board's decisions.

In view of the above, Applicant has shown that:

1. Applicant is entitled to some leeway in selecting what it chooses to treat as its mark;
2. The Examining Attorney has failed to consider Applicant's earlier arguments;
3. A majority of factors used to determine whether elements of a design are severable weigh in favor of Applicant; and
4. The Examining Attorney's arguments that the letter "P" of CETAPHIL dissects the slogan and the slogan "explains suggestive usage of CETAPHIL" (whatever that means) actually support registration based on the Board's precedent.

Accordingly, once again, Applicant respectfully requests that the Examining Attorney withdraw his refusal and accept the specimen as filed with the original application.

Respectfully submitted,

/g mathew lombard/

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SIGNATORY'S NAME	G. Mathew Lombard
SIGNATORY'S POSITION	Attorney for Applicant, NYS Bar Member
DATE SIGNED	02/11/2009

AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Feb 11 09:07:41 EST 2009
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PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77378145** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

This responds to the Office Action dated August 12, 2008.

The Examining Attorney has maintained – and made final – his refusal on the grounds that the specimen submitted at the time of filing does not match the drawing of the mark, and that Applicant must submit a new specimen. 37 C.F.R. §2.51(a); *see* 37 C.F.R. §2.72(a)(1).

Applicant continues to disagree with the Examining Attorney. Accordingly, Applicant submits this Request for Reconsideration.

Applicant fully incorporates by reference the arguments made in and evidence submitted with its July 21, 2008 Response to Office Action. To the extent necessary, Applicant may specifically make those arguments again or supplement them herein.

First, the Examining Attorney has ignored and, in fact, has not even addressed Applicant's argument that "in a §1 application, an applicant has some latitude in selecting the mark it wants to register. *The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.*" Emphasis added. TMFP § 807.12(d).

To the extent that “an applicant has some latitude in selecting the mark it wants to register,” this would suggest that the burden is on the U.S. Patent & Trademark Office to establish that the elements of a specimen are “inseparable for registration purposes.” The Board’s decision in *In re Green U.O.D., Inc.*, Serial No. 76615858, (TTAB March 31, 2008) confirms that the burden is the Examining Attorney’s. In that decision, the Board wrote: “Nonetheless, we find that there is at least some doubt involved, and that it is appropriate to resolve such doubt in applicant’s favor.” Applicant submits that the Examining Attorney has not met this burden. Since the latitude is Applicant’s – not the Examining Attorney’s – the specimen that Applicant selected should be accepted. To the extent that, at the very least, Applicant has shown that doubt exists, such doubt should be resolved in Applicant’s favor.

In its July 21, 2008 response, Applicant argued that: 1) “Every Age. Every Stage. Every Day.” presents “a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen,” TMEP § 807.12(a), and **CETAPHIL** with the background design creates its own commercial impression apart from the slogan; 2) the slogan is severable from **CETAPHIL** and the background design; and 3) that **CETAPHIL** is a recognized umbrella mark of Applicant.

The Examining Attorney rejected Applicant’s arguments.
CETAPHIL is Applicant’s House Mark

With regard to Applicant’s argument that **CETAPHIL** is a recognized umbrella mark for a full line of products offered by Applicant, the Examining Attorney rejects this outright with no explanation. He writes: “the argument that **CETAPHIL** is a separately recognized umbrella mark owned by applicant is not persuasive because it has no bearing on the specimen issue in this case.” The Examining Attorney offers no evidentiary, statutory or case law support for this proposition. However, he does incorporate the U.S. Patent & Trademark Office’s “catch-all” argument that “[p]rior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int’l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).” Applicant is not sure why this language was included. It seems wholly irrelevant to the Examining Attorney’s argument, especially since Applicant made no arguments based on earlier decisions of other Examining Attorneys.

However, the Examining Attorney inappropriately dismisses this argument out of hand. Since the specimen label contains Applicant’s umbrella mark **CETAPHIL** and Applicant’s umbrella mark **CETAPHIL** is included on the drawing, it is indeed relevant. See **EXHIBIT A**. The Examining Attorney may not simply dismiss an argument as irrelevant to avoid addressing the substantive merit of the argument. TMEP § 713.03 (“When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney should respond to the applicant’s arguments.”). Applicant submits that the Examining Attorney’s dismissal of Applicant’s argument as irrelevant fails to meet the requirement that the Examining Attorney “respond to the applicant’s arguments.”

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

Since Applicant has been using its CETAPHIL mark in commerce since at least as early as 1950 -- for almost 60 years -- it is obvious that a "word" portion which has been on the market for 60 years and is presented in a font size which is more than 300% larger than the other words in the label, that element of the mark is "more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services". Therefore, the fact that the CETAPHIL umbrella mark has been in use for more than 60 years and appears in a font size which is 300% larger than the other words on the label makes the fact that CETAPHIL is a well-known mark makes this argument very relevant.

Having been on the market continuously for nearly 60 years, Applicant's mark is known to the public. Since § 2(f) acquired distinctiveness is *presumed* by the U.S. Patent & Trademark Office after only five (5) years of use, after 60 years of use, Applicant's mark is known -- if not famous -- to the purchasing public.

Cases have frequently held that an applicant's use of its corporate name or its house mark along with another trademark does not create a unitary mark. *See, e.g., In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) ("The courts in a proper case may recognize the right to registration of one part of an owner's mark consisting of two parts."); *Textron Inc. v. Cardinal Engineering Corp.*, 164 USPQ 397, 399 (TTAB 1969) ("While the record does not show that Textron's principal or house mark 'HOMELITE' appears on its chain saw as well as in all of its advertising literature, there is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin"); *In re Emco, Inc.*, 158 USPQ 622, 623 (TTAB 1968) ("It is concluded that the law and the record support applicant's position that 'RESPONER' is registrable without addition of the surname 'MEYER'"); and *In re Barry Wright Corp.*, 155 USPQ 671, 672 (TTAB 1967) ("It is clear that the notation '8-48' stands out as a distinguishable element separate and apart from the statement 'ANOTHER 8-48 FROM MATHATRONICS'").

Even when terms have been physically joined in the specimens, case law recognizes that these terms can be separately registered if the evidence of record indicates that they will be recognized as distinct trademarks. *See In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (Holding that "the fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented by this case, create a unitary expression such that 'TINEL-LOCK' has no significance by itself as a trademark"); *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969) (GRIPLET creates a separate commercial impression despite overlapping with house mark BERG); *In re Dempster Brothers, Inc.*, 132 USPQ 300 (TTAB 1961) (Despite specimens showing the terms DEMPSTER DUMPMaster sharing the first and last letters, DUMPMaster separately registrable).

The Board specifically addressed this issue in *In re Royal BodyCare, Inc.*, ___ USPQ2d ___, Serial. No. 78976265 (TTAB Feb. 22, 2007), which was discussed in Applicant's July 21

Response. In that case, the Board reversed the refusal to register the term “NANOCEUTICAL,” finding that the term is actually used in a manner that creates a commercial impression separate and apart from the house mark or trade name “RBC’s,” where the mark appears as **RBC’S NANOCEUTICAL**.

Without addressing this decision or Applicant’s arguments based on that decision, the Examining Attorney concluded that the fact that **CETAPHIL** is an umbrella mark is irrelevant despite the obvious relevance as discussed in binding precedent.

The published, citable decisions of the Board make clear that the fact that Applicant’s **CETAPHIL** mark is a well-known umbrella or house mark for a range of its products is in fact relevant. In light of this obvious precedent which is available to the Examining Attorney as a record of the U.S. Patent & Trademark Office, his conclusion that “the argument that **CETAPHIL** is a separately recognized umbrella mark owned by applicant is not persuasive because it has no bearing on the specimen issue in this case” is clearly erroneous. It is relevant and the Examining Attorney must consider it since the cases cited above are cited for their legal precedence – not the similarity of factual issues.

The Standard of Review: Overall Commercial Impression

Whatever elements might be considered in determining whether the specimen is a substantially exact representation of the mark as shown in the drawing, the overall commercial impression remains controlling. *In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), citing *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983); *In re In Mook Kim* Serial No. 78483075, (TTAB July 14, 2006); *In re The Gray Foxes*, Serial No. 76544022, (TTAB September 30, 2005).

It is clear that when a consumer or prospective purchaser sees this mark on the shelf, she will be able to discern two (2) primary elements: the **CETAPHIL** umbrella mark and Applicant’s overlapping ellipses logo. A consumer would not be able to read the “Every Age. Every Stage. Every Day.” element of the label on a store shelf. Applicant’s position is supported by the photograph annexed hereto as **EXHIBIT B**, which shows Applicant’s actual products on an actual store shelf. Applicant directs the Examining Attorney’s attention to the fact that the background logo and **CETAPHIL** are legible; however, the “Every Age. Every Stage. Every Day.” slogan is unreadable from a normal shopping distance.

“[T]he shape and two-tone pattern would be discernible from a distance, even though the writing on the design would not be. Due to this manner of use, consumers would identify applicant’s golf clubs by the design alone. This also supports the conclusion that the design creates a separate commercial impression.” *In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), citing *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983) (“At a distance the words may be hard to read but the design stands out and provides a means of ready recognition”). In the instant case, “the shape and two-tone pattern would be discernible from a distance, even though the writing [Every Age. Every Stage. Every Day.] on the design would not be. Due to this manner of use, consumers would identify applicant’s [dermatological products] by the design [and house mark]. This also supports the conclusion that the design creates a separate commercial impression.” Applying this legal standard to the facts of the instant case, “[a]t a distance the words [Every Age. Every Stage. Every Day.] may be hard to read but the design [and house mark] stand[] out and provide[] a

means of ready recognition.”

Again, the inclusion of Applicant’s umbrella mark in a large font size is important to the analysis, despite the Examining Attorney’s cavalier and erroneous dismissal of these facts. Not only is it relevant, according to the decisions of the Board mentioned above, it strongly favors withdrawal of the Examining Attorney’s refusal.

Viewed from a consumer’s or prospective consumer’s perspective, from a distance while shopping, the commercial impressions made by the drawing and the mark are the same. This analysis has been specifically accepted by the Board. *See In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), *citing In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983).

Based on this representation of the mark, it is clear that **CETAPHIL** and the background logo are severable from the “Every Age. Every Stage. Every Day.” element. It also demonstrates the importance of the fact that **CETAPHIL** is a well-known umbrella mark for Applicant’s goods.

“[J]udicial notice may be taken of the fact that it is a common practice for manufacturers to apply both a house mark and a product mark to their various items of merchandise.” *Textron Inc. v. Cardinal Engineering Corp.*, 164 USPQ 397, 399 (TTAB 1969). Inasmuch as “judicial notice may be taken of the fact that it is a common practice for manufacturers to apply both a house mark [or umbrella mark] and a product mark to their various items of merchandise,” the Examining Attorney may not dismiss the relevance of the fact the **CETAPHIL** is a well-known umbrella mark.

The Examining Attorney argues that “Every Age. Every Stage. Every Day.” is not severable from the mark as depicted in the drawing because:

the elements **CETAPHIL** and **EVERY AGE. EVERY STAGE. EVERY DAY** slogan on the specimen label is contained within the inner design in extremely close proximity; in fact, the P in **CETAPHIL** dissects the slogan between **EVERY STAGE** and **EVERY DAY**. Thus, the commercial impression created by the specimen is that the term **CETAPHIL** and the slogan **EVERY AGE. EVERY STAGE. EVERY DAY** is inextricably linked. In addition to the extremely close proximity and placement within the label design, the slogan is part and parcel of the mark on the specimen because it explains suggestive usage of **CETAPHIL**. The slogan does not stand apart from **CETAPHIL** by physical separation or unrelatedness of the meaning of the slogan. The fact that the slogan is in a smaller font and color than **CETAPHIL** only serves to show the slogan is meant as an explanatory modifier of the use of **CETAPHIL**. Thus, the mark and slogan are not separable elements in this case.

The Examining Attorney’s argument that the “P” in **CETAPHIL** dissects the slogan between **EVERY STAGE** and **EVERY DAY** is not on point. **EXHIBIT C** contains definitions of the word “dissect”. By and large, every definition of “dissect” is conceptually the same: “To cut apart or separate body tissues or organs, especially for anatomical study”. The very word chosen by the Examining Attorney – “dissect” – implies that **CETAPHIL** and “Every Age. Every Stage. Every Day.” are distinct, severable elements. A thing does not typically dissect itself. The word

“dissect” implies that one separate thing is acting on something else. Thus, contrary to the Examining Attorney’s conclusion, dissection does not mean that the elements are “inextricably linked;” it means they are separate elements. Therefore, at most, this argument does nothing more than reiterate the fact that CETAPHIL and “Every Age. Every Stage. Every Day.” are physically close to each other. This argument adds nothing to the Examining Attorney’s overall argument. Contrasting the meaning of “dissect” with the meanings of “intertwined,” “merged,” and “interwoven,” the Examining Attorney’s position is weak.

In *In re Alchemy Nominees Pty LTD*, Serial No. 75/501,743, (TTAB July 22, 2003), the Board concluded, “[i]n this case, we acknowledge that the spatial placement and *overlapping* physical relationship of the wording ‘Decking Excellence’ (*i.e.*, underlining the word ‘Deck’ and covering up a portion of the word ‘One’) create some degree of physical connectedness between the literal elements of the composite mark shown on the specimen. On the other hand, we do not agree with the Trademark Examining Attorney that the word “Decking Excellence” is an inseparable element of the entire mark as shown on the specimens. Rather, we find that visually the laudatory term ‘Decking Excellence’ comprises and incidental overlay. As to connotation, the wording ‘Decking Excellence’ merely accentuates the ‘preeminent’ connotation of ‘Deck One.’”

In that same opinion, the Board concluded that, “Finally, the unique design of the critical components of the mark remain unchanged between these two presentations, leaving the overall commercial impression of the DECK ONE mark unchanged with this addition....”

EXHIBIT D includes the drawing and the specimen at issue in *In re Alchemy Nominees Pty LTD*.

Indeed, in *In re Alchemy Nominees Pty LTD* (Serial No. 75/501,743, July 22, 2003), the Examining Attorney described “the new wording element on the specimen as being ‘merged,’ ‘intertwined’ or ‘interwoven’ with DECK ONE.” Despite the Examining Attorney’s conceptualization of the additional matter being “merged,” “intertwined” or “interwoven” with the mark as shown on the drawing, the Board reversed the refusal. Here, the Examining Attorney concludes that the additional matter is dissected by another element of the label. “Dissect” imparts a very different meaning than “merge,” “intertwine,” or “interweave”. If the best that the Examining Attorney can conclude is that one element “dissects” the other element, it is impossible to conclude that those elements are not severable. For definitions of these words, see EXHIBIT E.

Contrary to *In re Alchemy Nominees Pty LTD* where there was actual “overlap,” Applicant’s mark here does not overlap with the CETAPHIL element. More importantly, here, like in *In re Alchemy Nominees Pty LTD*, “the unique design of the critical components of the mark remain unchanged between these two presentations, leaving the overall commercial impression of the [CETAPHIL & Design] mark unchanged with this addition....” This conclusion is confirmed by the fact that, from a distance, the label and the drawing create the same commercial impression.

Proximity of Elements

In the instant case, the Examining Attorney focuses on the fact that the elements are in close proximity. However, he places unjustified reliance on this one factor. He ignores that the font styles are different (standard vs. italicized) and the size difference between the elements is

enormous. This is reinforced by Applicant's specimen photograph in which "Every Age. Every Stage. Every Day." is barely readable or discernable from a "normal" shopping distance. *In re Karsten Manufacturing Corp.*, Serial No. 78347910, (TTAB September 12, 2005), citing *In re National Institute for Automotive Service Excellence*, 218 USPQ 744, 745 (TTAB 1983) ("At a distance the words may be hard to read but the design stands out and provides a means of ready recognition."). Indeed, two (2) of the three (3) factors considered by the Board in *In re Big Pig* weigh in favor of Applicant. Since the Examining Attorney has not established that the proximity factor is in any way more important or more relevant than the font size, font style factors or the fact that the elements appear on different lines, the Examining Attorney's exclusive reliance on the proximity of the elements is short-sighted.

The Board has, time and again, restated that proximity is not the deciding factor. "Contrary to the examining attorney's apparent contention, the mere fact that two or more elements of a composite mark are in close proximity to each other does not necessarily mean that those elements cannot be registered separately. Proximity is a consideration but it is not the only consideration. It is the overall commercial impression that is controlling." *In re The Gray Foxes*, Serial No. 76544022, (TTAB September 30, 2005).

Mere proximity "does not endow the whole a single, integrated, and distinct commercial impression." *Dena Corp. v. Belvedere International Inc.*, 960 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

"The fact that the wording is in close proximity to the graphic elements does not dictate that those elements cannot be registered separately. While proximity is a consideration, it is the overall commercial impression of the mark that is controlling." *In re In Mook Kim* Serial No. 78483075, (TTAB July 14, 2006).

The Examining Attorney also makes the argument that "the slogan is part and parcel of the mark on the specimen because it explains suggestive usage of CETAPHIL. The slogan does not stand apart from CETAPHIL by physical separation or unrelatedness of the meaning of the slogan." Applicant is unsure of what this means. "Because it explains suggestive usage of CETAPHIL" is so vague so as to be unhelpful. Similarly, "unrelatedness of the meaning of the slogan" is ill-explained.

For purposes of this argument, Applicant assumes that the Examining Attorney is somehow suggesting that that the slogan is the equivalent of "Directions for use". That is an irrelevant argument. First, the slogan is not directions. The back of the product includes "Directions For Use Without Water" and "Directions For Use With Water". See EXHIBIT F. No consumer would confuse the "Every Age. Every Stage. Every Day." with directions for use of the product. If the slogan functioned as the Examining Attorney suggests, that element would be considered merely descriptive under § 2(e)(1). The Examining Attorney has issued no such refusal.

Further, Applicant submits that the slogan is "suggestive" of how to use the product is non-sensical. "Suggestive use" is a notion fabricated by the Examining Attorney with no relevant meaning to trademark analysis. No reasonable person would conclude that "Every Age. Every Stage. Every Day." is intended as or suggests directions as how to use the product. Even if the Examining Attorney is correct and the slogan does function in that manner, it directs users how to

use the product – which means it is not inextricably linked to the mark. As the Examining Attorney well knows:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—
(1) used by a person, or
(2) which a person has a *bona fide* intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127

Since a trademark distinguishes one’s products from those of others *and* indicates the source of goods, the explanation of “suggestive usage” (to use the Examining Attorney’s words) explains use of the product – not the trademark.

This means that (1) the slogan refers to the product rather than the mark and (2) by consequence, it means that the slogan is severable from the remainder of the mark. If the language, as the Examining Attorney contends, suggests how to use the product, then its suggestive nature renders it severable from the remainder of the mark.

Accepting, *arguendo*, the Examining Attorney’s assessment of the slogan as “suggestive [of] usage,” this conclusion is not determinative. For example, in *In re Pharma Cosmetix Research, supra*, the Board concluded that “EPF is obviously an abbreviation for the phrase ENVIRONMENTAL PROTECTION FACTOR. However, the phrase also has its own meaning, apart from the abbreviation. See, e.g., *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1043 (TTAB 1985) (noting that although the pictorial representation of Pegasus, ‘may reinforce the word [Pegasus],’ the word also created its own separate commercial impression).”

Similarly, in *In re Alchemy Nominees Pty LTD, supra*, the Board concluded: “Rather, we find that visually the laudatory term ‘Decking Excellence’ comprises an incidental overlay. As to connotation, the wording ‘Decking Excellence’ merely accentuates the ‘preeminent’ connotation of ‘Deck One.’”

The Board’s assessment of these elements as an abbreviation or accentuation is essentially the same assessment as the Examining Attorney’s assessment that the slogan represents “suggestive usage” or “relatedness of the meaning of the slogan”. These conclusions are not determinative. In both *In re Pharma Cosmetix Research* and *In re Alchemy Nominees Pty LTD*, the material not included in the drawing was somehow related to or explanatory of the other elements of the mark. Nonetheless, the Board concluded that those elements created different commercial impressions. So, too, the Examining Attorney should conclude that “Every Age. Every Stage. Every Day.” creates a different distinct commercial impression and should withdraw his refusal.

Moreover, a “component does not need to create the dominant commercial impression in the composite mark in order to be registrable, it only has to create a separate commercial impression.” *In re Pharma Cosmetic Research, L.L.C.*, Serial No. 76269152 (TTAB October 11,

2007).

A Relevant Example

In addition to the cases discussed by Applicant above and in its July 21 ROA, Applicant directs the Examining Attorney's attention to Registration No. 3071013 (Application Serial No. 78598517) for the mark **CITRUCEL & Design** for *laxatives and dietary fiber supplements* in Class 5. The drawing filed in connection with Application Serial No. 78598517 and the specimen submitted therewith are annexed hereto as **EXHIBIT G**.

The specimen which was submitted – and accepted with no objection.

In the case of Registration No. 3071013, the specimen contains elements which are not included in the drawing. Specifically, it includes “Methylcellulose Fiber Therapy for Regularity” directly below **CITRUCEL**.

Additionally, it includes the following phrases in the orange graphic:

- No Excess Gas
- Doctor Recommended
- 100% Soluble Fiber
- Easy to Swallow
- 100 Fiber Caplets

Applicant directs the Examining Attorney's attention to the fact that “Methylcellulose Fiber Therapy for Regularity” appears in the same color and in close proximity to the much larger **CITRUCEL** element. Also, the phrases “No Excess Gas,” “Doctor Recommended,” “100% Soluble Fiber,” “Easy to Swallow,” and “100 Fiber Caplets” appear “within the inner design” and in the same yellow color which rings the orange graphic.

Applicant submits that the phrase “Methylcellulose Fiber Therapy for Regularity” appears at least as close to **CITRUCEL** as “Every Age. Every Age. Every Stage.” appears to **CETAPHIL**. Moreover, since both **CITRUCEL** and “Methylcellulose Fiber Therapy for Regularity” appear in the same color green (which is more unique and source-identifying than white), they – under the Examining Attorney's analysis – are linked.

Since the phrases “No Excess Gas,” “Doctor Recommended,” “100% Soluble Fiber,” “Easy to Swallow,” and “100 Fiber Caplets” appear “within the inner design” and in the same yellow color which rings the orange graphic, a closer association between these elements and the design exists than exists in the instant mark. Yet, no refusal issued.

Additionally, the phrases “No Excess Gas,” “Doctor Recommended,” “100% Soluble Fiber,” “Easy to Swallow,” and “100 Fiber Caplets” appear “within the inner design,” and “Methylcellulose Fiber Therapy for Regularity” is “suggestive of usage” of the mark. It tells the consumer what the product is used for. This is the same analysis the Examining Attorney applied to the instant application when he states that the slogan is “suggestive” of use. Yet, no refusal issued.

Applicant informs the Examining Attorney that Registration No. 3071013 issued in 2005. Applicant submits that there has been no change to trademark law, no change to the TMEP, no case law and no congressional statutory change which warrants different treatment of the instant mark from that covered by Registration No. 3071013. Therefore, the Examining Attorney should accept the instant specimen and withdraw the remaining refusal/requirement.

With regard to Registration No. 3071013, the specimen contained at least 19 additional words or terms not included in the drawing. By contrast, in the instant application, the specimen contains a mere six (6) additional terms. Therefore, if the CITRUCEL specimen qualified as a “substantially exact representation of the mark,” the instant specimen should qualify as a “substantially exact representation of the mark.”

While the Examining Attorney will argue he is not bound by the Examining Attorney’s decision in Registration No. 3071013, Applicant is not making that argument. Rather, Applicant submits this information as evidence as to how a proper examination of specimens should be undertaken. While the Examining Attorney may not be bound by the earlier Examining Attorney’s decision, Applicant submits that the Examining Attorney’s treatment of the specimens in Registration No. 3071013 follows the law and precedent – whereas the Examining Attorney in the instant case has deviated from proper analysis. In other words, the Examining Attorney for Reg. No. 3071013 applying the appropriate standard. The Examining Attorney in this case is not.

Next, the Examining Attorney argues that because of “the extremely close proximity and placement within the label design, the slogan is part and parcel of the mark on the specimen because it explains suggestive usage of CETAPHIL”. Accepting, *arguendo*, the Examining Attorney’s argument, the proximity of the elements is only one factor to be considered. *In re Jordan Outdoor Enterprises, Ltd.* (Serial No. 78298898, August 9, 2006) (“Contrary to the examining attorney’s contention, the mere fact that two or more elements of a composite mark are in close proximity to each other does not necessarily mean that those elements cannot be registered separately. Proximity is a consideration, but it is the overall commercial impression of the mark that is controlling.”). In *In re Big Pig, Inc.*, 81 USPQ2d 1436 (TTAB 2006), the Board considered “the word ... is displayed in a different color, type style, and size such that it stands out from the remaining words and design element”. In *In re Big Pig, Inc.*, despite the proximity of the elements of the mark, the Board concluded that the elements were severable. Moreover, in that case, the applicant argued that “[t]he other elements clearly form the background.”

Applicant is mindful that the U.S. Patent & Trademark Office takes the position that Examining Attorneys are not bound by the decisions of other Examining Attorneys. Nonetheless, a potential applicant, when making its determination whether a proposed mark is registerable, is entitled to a certain degree of reliance on the U.S. Patent & Trademark Office’s treatment of similar marks. This position is embraced by the Federal Circuit and the Trademark Trial & Appeal Board. The Court of Appeals for the Federal Circuit, in *In re Merrill, Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q. 2d 1141, 1144 (Fed. Cir. 1987), specifically held that the analysis of whether a mark is descriptive is to be undertaken “in accordance with practice and precedent.” Furthermore, as stated by the Board in *In re Consol. Cigar*, 35 U.S.P.Q. 2d 1290, 1295 (T.T.A.B. 1995), “uniform treatment under the Trademark Act is desirable. . .” Also, “the Office strives for consistency”. *In re Sun Microsystems, Inc.*, Serial No. 75/430,476, (TTAB March 9, 2001). Inasmuch as uniform treatment is desirable, to the extent that an Examining

Attorney wishes to use the argument that he is not bound by the decisions of other Examining Attorneys, the Board's admonition that uniform treatment is desirable and that federal agencies must engage in reasoned decision making must be interpreted as meaning Examining Attorneys may not simply dismiss earlier decisions *without reason* other than he is not bound by earlier decisions. The Examining Attorney must offer some explanation: a change in law, a misapplication of law in the earlier decision or other error, a factual distinction, a change in the public's understanding of a term, etc. However, not being bound by an earlier decision – alone – is not a justification for refusal. If the Office “strives for consistency,” an inconsistent decision must be explained. Here, the Examining Attorney has offered nothing other than the U.S. Patent & Trademark Office's “get out of jail free card” of “Examining Attorneys are not bound by the decisions of other Examining Attorneys.”

While it may be the position of the U.S. Patent & Trademark Office that the Examining Attorney is not *bound* by the decisions of other Examining Attorneys, the examples above clearly show how the U.S. Patent & Trademark Office and other Examining Attorneys have treated nearly identical (or at least similar) situations. In light of the acceptance of the specimens in connection with Registration No. 3071013 and the Board's decision in *In re Big Pig, Inc.*, it is clear that the Examining Attorney's analysis is incorrect and contravenes the position of the U.S. Patent & Trademark Office.

Moreover, the cases offered by the Examining Attorney are not on point to the facts of this case. For example, *AMF Inc. v. Am. Leisure Prods., Inc.* stands for the proposition that the existence of third party registrations does not mean that another confusingly similar mark should be registered. Additionally, when doubt exists as to a § 2(d) refusal, doubt must be resolved in favor of the prior registrant. In this case, there is no § 2(d) refusal and since an applicant is entitled to discretion in determining what its mark is, this decision is not controlling.

With regard to *In re Int'l Taste, Inc.*, that decision involved a situation where several registered marks in which the word “Hollywood” is disclaimed and two registrations with no disclaimer of the term “Hollywood.” In that case, the Office treated the word “Hollywood” inconsistently. Despite this fact, the Board wrote, “while the Office strives for consistency, the Board must decide each case on its own facts and record.” Again, the Board noted the importance of consistency. Moreover, in this case, the Board *reversed* the Examining Attorney's decision and decided in favor of the applicant. In that case, consistency led to a decision favorable to the applicant.

With regard to *In re Sunmarks, Inc.*, the Board held that the Board is not bound by the decisions of other Examining Attorneys. Moreover, *In re Sunmarks* involved a likelihood of confusion issue when the applicant sought to obtain a second or subsequent registration of **ULTRA** for an expanded list of goods from its first registration. In the instant case, there is no likelihood of confusion issue. Applicant is not seeking a second registration. *In re Sunmarks* also stands for the proposition that when doubt exists as to a § 2(d) refusal, doubt must be resolved in favor of the prior registrant. However, as *In re Green U.O.D., Inc.*, *supra*, makes clear, doubt as to the severability of elements of a mark should be resolved in Applicant's favor. Since an applicant is entitled to discretion in determining what its mark is, this decision is not controlling.

None of these cases are directly on point and none stands for the sweeping proposition that

Examining Attorneys may arbitrarily refusal registration with impunity and hide behind the provision of TMEP § 1216.01. In each of those cases, there was some valid basis to distinguish the case at issue from the prior decisions.

While the Examining Attorney has focused [incorrectly] on the proximity of the “Every Age. Every Stage. Every Day.” it must be remembered that the overall commercial impression is controlling. In *In re Alchemy Nominees Pty LTD*, the Board found it “helpful” to review decisions in which the applied-for element were in fact found to be “inextricably bound together”. EXHIBIT H shows the drawings and the specimens in these cases, and includes the *In re Alchemy Nominees Pty LTD* decision.

Inasmuch as the Board found it helpful to review cases in which the elements of the marks were not severable, Applicant believes that it is equally instructive to review those cases when the Board concluded that the elements of marks were severable and created distinct commercial impressions. EXHIBIT I shows the drawings and the specimens in these cases. The marks identified in EXHIBIT I are more similar to the instant mark than those identified by the Examining Attorney or those in EXHIBIT H.

Using the ultimate test which is the “the overall commercial impression,” Applicant submits that the CETAPHIL and the background logo create a distinct commercial impression from the “Every Age. Every Stage. Every Day.” slogan. This conclusion is supported by the history of the Board’s decisions.

In view of the above, Applicant has shown that:

1. Applicant is entitled to some leeway in selecting what it chooses to treat as its mark;
2. The Examining Attorney has failed to consider Applicant’s earlier arguments;
3. A majority of factors used to determine whether elements of a design are severable weigh in favor of Applicant; and
4. The Examining Attorney’s arguments that the letter “P” of CETAPHIL dissects the slogan and the slogan “explains suggestive usage of CETAPHIL” (whatever that means) actually support registration based on the Board’s precedent.

Accordingly, once again, Applicant respectfully requests that the Examining Attorney withdraw his refusal and accept the specimen as filed with the original application.

Respectfully submitted,

/g mathew lombard/

EVIDENCE

Evidence in the nature of various exhibits supporting Applicant's arguments. has been attached.

Original PDF file:

http://tgatc/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_001/evi_19046890-085920247_Ex_A.pdf

Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_002/evi_19046890-085920247_.Exhibit_B.pdf

Converted PDF file(s) (4 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_003/evi_19046890-085920247_.Exhibit_C.pdf

Converted PDF file(s) (4 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_004/evi_19046890-085920247_.Exhibit_D.pdf

Converted PDF file(s) (23 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

Evidence-10

Evidence-11

Evidence-12

Evidence-13

Evidence-14

Evidence-15

Evidence-16

Evidence-17

Evidence-18

Evidence-19

Evidence-20

Evidence-21

Evidence-22

Evidence-23

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_005/evi_19046890-085920247_.Exhibit_E.pdf

Converted PDF file(s) (10 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

Evidence-10

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_006/evi_19046890-085920247_.Exhibit_F.pdf

Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_007/evi_19046890-085920247_.Exhibit_G.pdf

Converted PDF file(s) (13 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

Evidence-10

Evidence-11

Evidence-12

Evidence-13

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_008/evi_19046890-085920247_.Exhibit_H.pdf

Converted PDF file(s) (15 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

Evidence-10

Evidence-11

Evidence-12

Evidence-13

Evidence-14

Evidence-15

Original PDF file:

http://tgate/PDF/RFR/2009/02/11/20090211090741783532-77378145-009_009/evi_19046890-085920247_.Exhibit_I.pdf

Converted PDF file(s) (3 pages)

Evidence-1

Evidence-2

Evidence-3

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /g mathew lombard/ Date: 02/11/2009

Signatory's Name: G. Mathew Lombard

Signatory's Position: Attorney for Applicant, NYS Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77378145

Internet Transmission Date: Wed Feb 11 09:07:41 EST 2009

TEAS Stamp: USPTO/RFR-190.4.68.90-200902110907417835

32-77378145-44062b4e39ff4cb4ca6ed8562a10

4c68f7-N/A-N/A-20090211085920247210

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE EXAMINING ATTORNEY

Att. Ref. 102-0590

In re: the Application of

GALDERMA S.A.

Application Serial No. 77/378,145

For **CETAPHIL & Design**

in Class 3

Filed: January 23, 2008

Law Office: 102

Examining Attorney: Anthony M. Rinker

AFFIDAVIT OF MAUD ROBERT

I, MAUD ROBERT, depose, affirm and say that:

1. I am Trademark Counsel of Galderma S.A., a Swiss société anonyme with a principal place of business at Zugerstrasse 8, Cham 6330 Switzerland ("Applicant").
2. I am over the age of eighteen (18) and am competent to make this affidavit.
3. I have personal knowledge of the matters which are the subject of this affidavit, or I have obtained such information from the business and/or trademark records of Applicant.
4. I am authorized by Galderma S.A. to make these statements and to execute this affidavit.
5. Applicant – through its related, companies, subsidiaries, predecessors-in-title and/or predecessors-in-interest – has been using its **CETAPHIL** umbrella (or house) mark on a full range of dermatological products (including but not limited to soaps, washes, cleansers, lotions and creams) since at least as early as 1950.
6. The **CETAPHIL** mark is the most publicly recognized mark of Applicant.
7. For the 2007 fiscal year, gross sales of products bearing the **CETAPHIL** mark in the United States alone exceeded \$ 132 millions.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that all statements made of her own knowledge are true; and that all statements made on information and belief are believed to be true.

Dated: Paris, France
February 10, 2009

GALDERMA S.A.

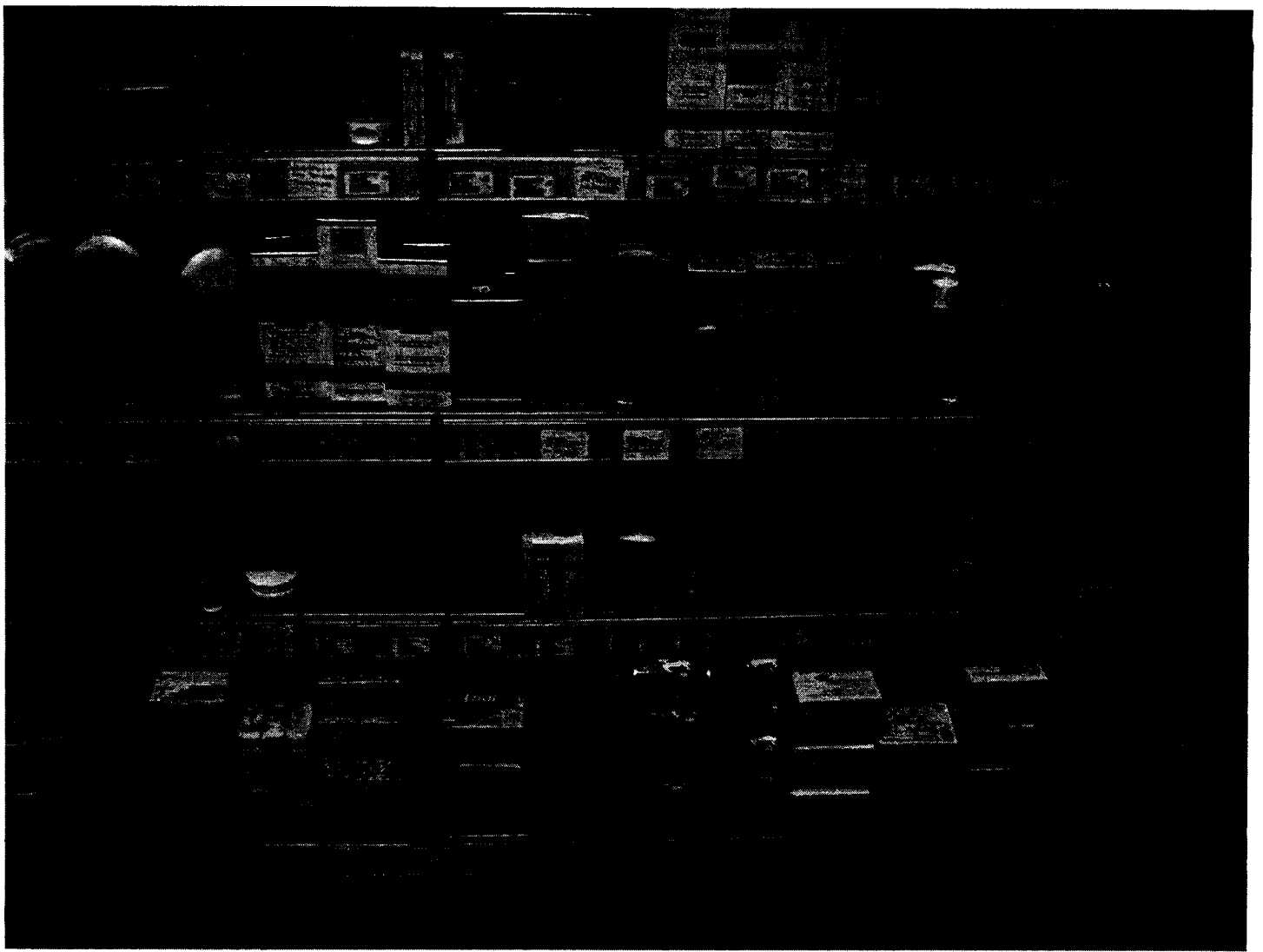
Zugerstrasse 8

CH-6330 CHAM

Maud ROBERT
Trademark Counsel
Galderma S.A.

EXHIBIT B





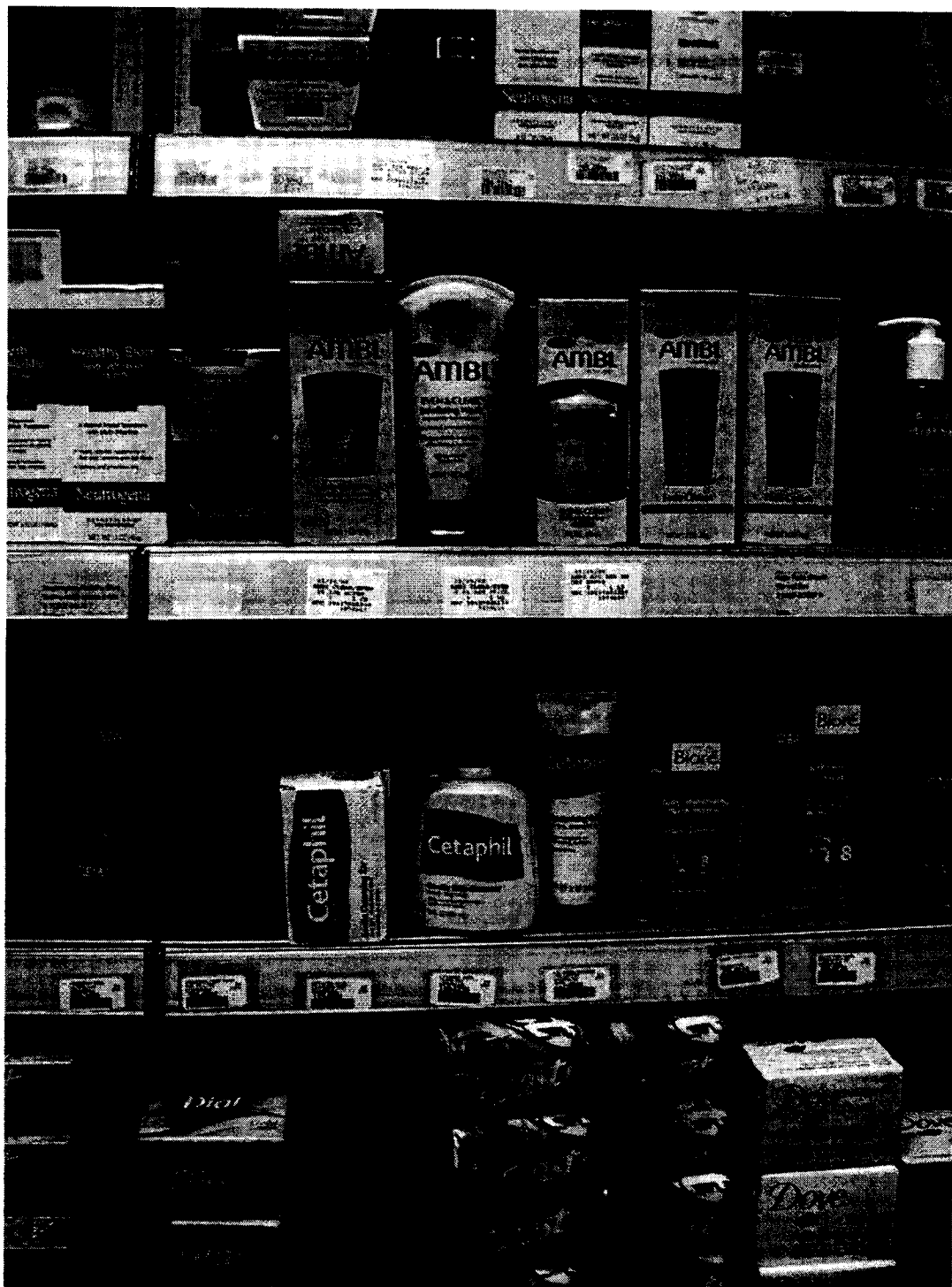
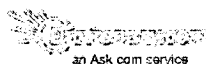


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dis·sect [di-sekt, dahy-] Show IPA Pronunciation ⓘ

-verb (used with object)

- to cut apart (an animal body, plant, etc.) to examine the structure, relation of parts, or the like
- to examine minutely part by part; analyze: *to dissect an idea.*

Origin:

1600-10, < L. *dissectus* (ptp. of *dissecāre* to cut up), equiv. to *dis-* + *sec-* cut + *-tus* plp. suffix

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dis·sect (dī'sekt', dī- dī'sekt') Pronunciation Key

tr v dis·sect·ed, dis·sect·ing, dis·sects

- To cut apart or separate (tissue), especially for anatomical study.
- To examine, analyze, or criticize in minute detail: *dissected the plan afterward to learn why it had failed.* See Synonyms at [analyze](#).

[Latin *dissecāre*, *dissect-*, *to cut apart*: *dis-*, *dis-* + *secāre*, *to cut up*; see *sek-* in Indo-European roots.]

dis·sect·i·ble adj., dis·sec·tor n.

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dissect

verb

- cut open or cut apart: "dissect the bodies for analysis"
- make a mathematical, chemical, or grammatical analysis of; break down into components or essential features: "analyze a specimen", "analyze a sentence"; "analyze a chemical compound" [syn: analyze] [ant: synthesise]

WordNet® 3.0, © 2006 by Princeton University. - Cite This Source

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dissect (dī'sekt', dī'sekt') Pronunciation Key

- To cut apart or separate body tissues or organs especially for anat
- In surgery, to separate different anatomical structures along nature

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dissect dis·sect (dĭ-sĕkt', dĭ-, dĭ'sĕkt')

v. dis·sect·ed, dis·sect·ing, dis·sects

1. To cut apart or separate tissue, especially for anatomical study.
2. In surgery, to separate different anatomical structures along natural lines by dividing the connective tissue framework.

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Dissect

Dis·sect¹. v. t. [imp. & p. p. Dissected, p. pr. & vb. n. Dissecting.] [*L. dissectus*, p. p. of *dissecare*; *dis-* + *secare* to cut. See [Section](#).]

1. (Anat.) To divide into separate parts; to cut in pieces, to separate and expose the parts of, as an animal or a plant, for examination and to show their structure and relations; to anatomize

2. To analyze, for the purposes of science or criticism; to divide and examine minutely

This paragraph . . . I have dissected for a sample. --Atterbury.

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EXHIBIT D



Close-up of Relevant Portion of Specimen

Int. Cl.: 6

Prior U.S. Cls.: 2, 12, 13, 14, 23, 25 and 50

United States Patent and Trademark Office

Reg. No. 2,746,682

Registered Aug. 5, 2003

TRADEMARK
PRINCIPAL REGISTER



ALCHEMY NOMINEES PTY LTD (AUSTRALIA
CORPORATION)

101 LITTLE CHESTER STREET, TENERIFFE
QUEENSLAND, 4005, AUSTRALIA

FOR: METAL BUILDING PRODUCTS NAMELY
NAILS, SCREWS, BOLTS, METAL STRAPPING AND
FASTENERS FOR HOLDING DECKING PLANKS
TO A TIMBER JOIST, IN CLASS 6 (U.S. CLS. 2, 12, 13,
14, 23, 25 AND 50).

OWNER OF AUSTRALIA REG. NO. 764207, DA-
TED 6-9-1998, EXPIRES 6-9-2008.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "DECK", APART FROM THE
MARK AS SHOWN.

SER. NO. 76-436,127, FILED 7-31-2002.

HELLEN BRYAN-JOHNSON, EXAMINING ATTOR-
NEY

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

Apr 23, 2003

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|--------------------------------------|---|
| 1. Serial No.:
76/436,127 | 2. Mark:
DECK ONE
and design |
| 3. International Class(es):
6 | |
| 4. Publication Date:
May 13, 2003 | 5. Applicant:
ALCHEMY NOMINEES PTY LTD |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202) 512-1800

By direction of the Commissioner.

Correspondence Address:

DAVID G. BOUTELL
FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 RAMBLING ROAD
KALAMAZOO, MICHIGAN 49008-1699

TMP&I

07-31-2002

U.S. Patent & TMOfo/TM Mail RcptDt #31

Express Mail No.: EV 099 080 355 US

THIS APPLICATION IS BASED ON AUSTRALIAN REG. NO. 764207,
REGISTERED ON JUNE 9, 1998.

Applicant: ALCHEMY NOMINEES PTY LTD

Address: 101 Little Chester Street
Teneriffe, Queensland 4005
AUSTRALIA

Applicant has a bona fide
intention to use the mark
in commerce with the
United States on or in
connection with the following
Goods:

Metal building products namely nails, screws,
bolts, metal building strapping and fasteners for
holding decking planks to a timber joist.

Disclaimer:

No claim is made to the exclusive right to use
"DECK" apart from the mark as shown.

print



*** User: hjohnson ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	0	0	0	0	0:01	*deckone*[bi,ti]
02	12401	N/A	0	0	0:02	*de{"ckxq"}*[bi,ti]
03	56198	N/A	0	0	0:01	*one*[bi,ti]
04	179	82	97	31	0:01	2 and 3
05	4052	N/A	0	0	0:05	2 and "006"[cc]
06	324	N/A	0	0	0:03	2 and ("006 " a b 200)[ic]
07	15362	N/A	0	0	0:05	3 and "006"[cc]
08	574	N/A	0	0	0:04	3 and ("006 " a b 200)[ic]
09	9	4	5	3	0:02	8 and (namils or screw or fastneers or strapping)[gs]
10	12	4	8	6	0:01	8 and nails[gs]
11	22384	N/A	0	0	0:07	3 and "035"[cc]
12	4978	N/A	0	0	0:05	3 and ("035 " a b 200)[ic]
13	12	4	8	2	0:01	12 and (nails or screws or bolts or strapping ro fasteners)[gs]

Session started 2/5/03 10:20:30 AM
Session finished 2/5/03 10:32:46 AM
Total search duration 0 minutes 38 seconds
Session duration 12 minutes 16 seconds

Default NEAR limit= 1 ADJ limit= 1

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TRADEMARK APPLICATION
IN THE U.S. PATENT AND TRADEMARK OFFICE

September 30, 2002

Applicant(s) : ALCHEMY NOMINEES PTY LTD
Mark : DECK One (& Design)
Serial No. : 76/436 127 Class(es) : 6 (Int'l)
Filed : July 31, 2002 Atty. Docket
No.: Fisher TM 3-1

The Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VIRGINIA 22202-3513
Attention: Preexamination File Receipt Section

REQUEST FOR CORRECTED FILING RECEIPT

Dear Sirs:

The pending Filing Receipt contains error(s).

Please supply a corrected Filing Receipt conforming to
the attached, red-corrected photocopy.

In support, see the highlighted portions of the attached
photocopy(ies), made from Applicant's file of:

1. Certified Copy of Australian Reg. No. 764207 (two
pages).

Respectfully submitted,



David G. Boutell

DGB/sp

FLYNN, THIEL, BOUTELL	Dale H. Thiel	Reg. No. 24 323
& TANIS, P.C.	David G. Boutell	Reg. No. 25 072
2026 Rambling Road	Ronald J. Tanis	Reg. No. 22 724
Kalamazoo, MI 49008-1699	Terryence F. Chapman	Reg. No. 32 549
Phone: (616) 381-1156	Mark L. Maki	Reg. No. 36 589
Fax: (616) 381-5465	David S. Goldenberg	Reg. No. 31 257
	Sidney B. Williams, Jr.	Reg. No. 24 949
	Liane L. Churney	Reg. No. 40 694
	Brian R. Tumm	Reg. No. 36 328
	Tricia R. Cobb	Reg. No. 44 621

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FILING RECEIPT FOR TRADEMARK APPLICATION

Page 01 of 01

Receipt on the DATE OF FILING of the application for registration and filing fees is acknowledged for the mark identified below. The DATE OF FILING is contingent upon the collection of any payment made by check or draft. Your application will be considered in the order in which it was received and you will be notified as to the examination thereof. Action on the merits should be expected from the Patent and Trademark Office in approximately 06 months from the filing date. When inquiring about this application, include the SERIAL NUMBER, DATE OF FILING, OWNER NAME, and MARK.

DAVID G. BOUTELL
 FLYNN, THIEL, BOUTELL & TANIS, P.C.
 2026 RAMBLING ROAD
 KALAMAZOO, MICHIGAN 49008-1699

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SBW____TLH____KC____
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PLEASE REVIEW THE ACCURACY OF THE FILING RECEIPT DATA.

A request for correction to the filing receipt should be submitted within 30 days to the following address: ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513. The correspondence should be marked to the attention of the Preexamination File Receipt Section. Or fax a request to 703-308-9096. The Patent and Trademark Office will review the request and make corrections when appropriate.

SERIAL NUMBER: 76/436127
 FILING DATE: Jul 31, 2002
 REGISTER: Principal
 LAW OFFICE: 104
 MARK: DECK ONE
 MARK TYPE(S): Trademark
 DRAWING TYPE: Words, letters, or numbers and design
 FILING BASIS: Sect. 44 (Foreign Basis)

ATTORNEY: David G. Boutell

DOMESTIC REPRESENTATIVE: FLYNN, THIEL, BOUTELL & TANIS, P.C.

OWNER: ALCHEMY NOMINEES PTY LTD (AUSTRALIA, Corporation)
 101 Little Chester Street, Teneriffe
 Queensland, 4005, AUSTRALIA

FOR: METAL BUILDING PRODUCTS NAMELY NAILS, SCREWS, BOLTS, METAL STRAPPING AND FASTENERS
 FOR HOLDING DECKING PLANKS TO A TIMBER JOIST
 INT. CLASS: 006

ALL OF THE GOODS/SERVICES IN EACH CLASS ARE LISTED

FOREIGN REGISTRATION DATA

Sec 44(e) claimed on AUSTRALIA reg. no. 764207, reg. dated Jun 9, 2002, reg. expires Jun 9, 2008.

1998



Expiry: 17 EV 07/06/2008
Mark: Deck One (s Design)
Applicant: Alchemy Design Pty Ltd

Trade Marks Office
Canberra

I, PENELOPE BAILEY, DEPUTY REGISTRAR, TRADE MARKS OFFICE, hereby certify that the annexed is a true copy of the entry appearing in the Register in respect of Trade Mark No. 764207.

I further certify that Trade Mark No. 764207 is in full force and effect until 9 June 2008 and may be renewed for further 10 year periods upon compliance with official requirements.

WITNESS my hand this SEVENTEENTH day of June, 2002.

Penelope Bailey

PENELOPE BAILEY
DEPUTY REGISTRAR
TRADE MARKS OFFICE





Commonwealth
of Australia

Register of trade marks

764207

Trade Marks Act 1995

Trade Mark Number: 764207

Owner: Alchemy Nominees Pty Ltd ACN/ARBN 058 917 712 of 101 Little
Chester Street TENERIFFE QLD 4005 AUSTRALIA

Goods and/or Services: **Class 6**
Metal building products including nails, screws, bolts, metal building
strapping and other fasteners; fasteners for holding decking planks to
a timber joist

Registration Date: 9 JUNE 1998

Sealing Date: 1 DECEMBER 1999

Trade Mark

 **DECK**
One

76436127

76436127

TRADEMARK APPLICATION SERIAL NC

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

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TRADEMARK APPLICATION

Express Mail Label No.: EV 099 080 355 US

IN THE U.S. PATENT AND TRADEMARK OFFICE

July 30, 2002

Applicant(s): ALCHEMY NOMINEES PTY LTD

Mark: DECK One (& Design)

Class: 6 (Int'l)

Atty. Docket No.: Fisher TM 3-1

Box Trademark Application

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

Sir:

Herewith is an application for registration of the above-identified mark, such application comprising the following parts:

Application, including Power of Attorney and
Appointment of Domestic Representative

Certified Copy of Australian Reg. No. 764207

Drawing


Check for \$325.00 to cover fees

Acknowledgement Postal Card

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or to credit any overpayment, to Deposit Account No. 06-1382. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

IN DUPLICATE


David G. Boutell

DGB/kc

Encl: As listed above

FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 Rambling Road
Kalamazoo, Michigan 49008-1699
Phone: (269) 381-1156
Fax : (269) 381-5465

400.0900

Foreign Associate/Client

TRADEMARK/SERVICE MARK
APPLICATION, PRINCIPAL
REGISTER, WITH DECLARATION

Mark: DECK One (& Design)

Class No.: 6 (Int'l)

To the ASSISTANT COMMISSIONER FOR TRADEMARKS:

Applicant Name: ALCHEMY NOMINEES PTY LTD
101 Little Chester Street, Teneriffe, Queensland,
4005, Australia
Applicant Business Address:

1. Applicant Entity: (Check one and supply requested information)

☐ a. Individual - Citizenship: (Country) _____

☐ b. Partnership - Partnership Domicile: (State and Country)

Names and Citizenship (Country) of General Partners:

☒ c. ~~Corporation~~ - State (Country, if appropriate) of
Incorporation: AUSTRALIA

☐ d. Other: (Specify Nature of Entity and Domicile)

2. Goods and/or Services:

Applicant requests registration of the above-identified trademark/service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended) for the following goods/services:

Metal building products namely nails, screws, bolts,
metal strapping and fasteners for holding decking planks
to a timber joist.

3. Basis for Application:

☐ a. **BASED ON ACTUAL USE (Section 1A)**

Applicant is using the mark in commerce on or in connection with the above-identified goods/services. (15 U.S.C. 1051(a), as amended) One specimen showing the mark as used in commerce is submitted with this application.

• Date of first use of the mark anywhere:

- Date of first use of the mark in commerce which the U.S. Congress may regulate: _____

☐ b. **BASED ON INTENT TO USE (Section 1B)**

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services. (15 U.S.C. 1051(b), as amended)

☐ c. **BASED ON FOREIGN APPLICATION (Section 44D)**

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services, and asserts a claim of priority based upon a foreign application in accordance with 15 U.S.C. 1126(d), as amended.

- Country of foreign filing: _____
- Date of foreign filing: _____

☒ d. **BASED ON FOREIGN REGISTRATION (Section 44E)**

Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services and bases this application on a foreign registration in Applicant's country of origin in accordance with 15 U.S.C. 1126(e), as amended.

- Country of registration: AUSTRALIA
- Registration number: 764207

4. Applicant hereby appoints Dale H. Thiel, David G. Boutell, Ronald J. Tanis, Terryence F. Chapman, Sidney B. Williams, Jr., Mark L. Maki, David S. Goldenberg, Liane L. Churney, Brian R. Tumm and Tricia R. Cobb, all attorneys at law and all members of the Bar of the State of Michigan, to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration. The Patent and Trademark Office is requested to send all correspondence to:

Contact Person: David G. Boutell

Address : FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 Rambling Road
Kalamazoo, Michigan 49008-1699.

5. FLYNN, THIEL, BOUTELL & TANIS, P.C., whose postal address is 2026 Rambling Road, Kalamazoo, Michigan 49008-1699, is hereby designated applicant's representative upon whom notice or processes in proceedings affecting this mark may be served.

6. The undersigned, an officer of applicant, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the above-identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

24-7-02
Date

M. J. Wilks
Signature (Required for filing date)

Michael WILKS (Director)
Print or Type Name and Title

TRADEMARK APPLICATION

"Express Mail" Mailing Label No.: EV 099 080 355 US

IN THE U.S. PATENT AND TRADEMARK OFFICE

Date of Mailing: July 30, 2002

Applicant(s): ALCHEMY NOMINEES PTY LTD

Mark: DECK One (& Design)

Serial No.: Unknown

Class: 6 (Int'l)

Filed: Unknown

Atty. Docket No.: Fisher TM 3-1

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

EXPRESS MAILING CERTIFICATE

Sir:

I hereby certify that the attached paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

FLYNN, THIEL, BOUTELL & TANIS, P.C.

By: 

Date: July 30, 2002

Document(s) attached: Trademark Application Transmittal
dated July 30, 2002 (in duplicate)
including enclosures listed thereon

Telephone: (269) 381-1156

482.9912

TRADEMARK APPLICATION

Express Mail Label No.: EV 099 080 355 US

IN THE U.S. PATENT AND TRADEMARK OFFICE

July 30, 2002

Applicant(s): ALCHEMY NOMINEES PTY LTD

Mark: DECK One (& Design)

Class: 6 (Int'l)

Atty. Docket No.: Fisher TM 3-1

Box Trademark Application
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Herewith is an application for registration of the above-identified mark, such application comprising the following parts:

Application, including Power of Attorney and
Appointment of Domestic Representative

Certified Copy of Australian Reg. No. 764207
Drawing


Check for \$325.00 to cover fees

Acknowledgement Postal Card

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or to credit any overpayment, to Deposit Account No. 06-1382. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

IN DUPLICATE.



David G. Boutell

DGB/kc

Encl: As listed above

400.0900

FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 Rambling Road
Kalamazoo, Michigan 49008-1699
Phone: (269) 381-1156
Fax : (269) 381-5465



Express # EV 099 080 355 US
Mark: Deck One (4 Design)
Applicant: Alchemy Nominees
PTY Ltd

Trade Marks Office
Canberra

I, PENELOPE BAILEY, DEPUTY REGISTRAR, TRADE MARKS
OFFICE, hereby certify that the annexed is a true copy of the entry appearing in the
Register in respect of Trade Mark No. 764207.

I further certify that Trade Mark No. 764207 is in full force and effect
until 9 June 2008 and may be renewed for further 10 year periods upon compliance
with official requirements.

WITNESS my hand this SEVENTEENTH day of
June, 2002.

PENELOPE BAILEY
DEPUTY REGISTRAR
TRADE MARKS OFFICE





764207

Register of trade marks

Trade Marks Act 1995

Trade Mark Number: 764207

Owner: Alchemy Nominees Pty Ltd ACN/ARBN 058 917 712 of 101 Little Chester Street TENERIFFE QLD 4005 AUSTRALIA

Goods and/or Services: **Class 6**
Metal building products including nails, screws, bolts, metal building strapping and other fasteners; fasteners for holding decking planks to a timber joist

Registration Date: 9 JUNE 1998

Sealing Date: 1 DECEMBER 1999

Trade Mark



17/06/02
14:30:03

TRADE MARKS SYSTEM
Amendment History for Registration 764207

(TMCC02AA) V7.0
COTAHN
Page No:

CURRENT OWNER DETAILS

Alchemy Nominees Pty Ltd
ACN/ARBN 058 917 712
of 101 Little Chester Street
TENERIFFE QLD 4005
AUSTRALIA

POST-REGISTRATION AMENDMENT HISTORY :

U.S. Patent & TMO/TM Mail Rpt Dt. #31

07-31-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #31

Express Mail No.: EV 099 080 355 US

THIS APPLICATION IS BASED ON AUSTRALIAN REG. NO. 764207,
REGISTERED ON JUNE 9, 1998.

Applicant: ALCHEMY NOMINEES PTY LTD

Address: 101 Little Chester Street
Teneriffe, Queensland 4005
AUSTRALIA

Applicant has a bona fide
intention to use the mark
in commerce with the
United States on or in
connection with the following
Goods:

Metal building products namely nails, screws,
bolts, metal building strapping and fasteners for
holding decking planks to a timber joist.

Disclaimer:

No claim is made to the exclusive right to use
"DECK" apart from the mark as shown.

The logo features the word "DECK" in a bold, sans-serif font, followed by "One" in a stylized, cursive script. A thick, black, curved line underlines the word "One".

U.S. Patent & TMO/TM

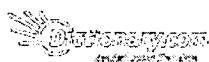
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76436127

EXHIBIT E

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
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www.business.commerge  [murj] Show IPA Pronunciation 

verb, merged, merg-ing.

-verb (used with object)

1. to cause to combine or coalesce: unite.
2. to combine, blend, or unite gradually so as to blur the individuality or individual identity of: *They voted to merge the two branch offices into a single unit.*

-verb (used without object)

3. to become combined, united, swallowed up, or absorbed; lose identity by uniting or blending (often fol. by *in* or *into*): *This stream merges into the river up ahead.*
4. to combine or unite into a single enterprise, organization, body, etc.: *The two firms merged last year.*

Origin:

1630-40; < L. *mergere* to dip, immerse, plunge into water

Dictionary.com Unabridged

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[Cite This Source](#)

Language Translation for: merge


Spanish: unir, German: verschmelzen, Japanese: 合併する
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www.business.commerge  (mürj) [Pronunciation Key](#)

v. merged, merg-ing, merges

v. *tr.*

1. To cause to be absorbed, especially in gradual stages.
2. To combine or unite. *merging two sets of data.*

v. *intr.*

1. To blend together, especially in gradual stages.
2. To become combined or united. See Synonyms at [mix](#).

[Latin *mergere*, to plunge]mer'gence *n.*

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merge

1636, "to plunge or sink in," from L. *mergere* "to dip, immerse," *pro* *mazgoju* "to wash." Legal sense of "absorption of an estate, contract" 1889, not common until c. 1928.

merethoxyline pr.

Meretricious

meretriciously

meretriciousness

Merganser

merge

merge in

merged

mergee

mergence

Mergent, Inc.

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merge

verb

1. become one; "Germany unified officially in 1990"; "the cells merge" [syn: unify] [ant: break apart]

2. mix together different elements; "The colors blend well"
3. join or combine; "We merged our resources" [syn: unite]

Merge

Merge\, v. t. [imp. & p. p. Merged; p. pr. & vb. n. Merging.] [L. mer-
immerse, to sink; to absorb.]

To merge all natural . . . sentiment in inordinate vanity --Burke

Whig and Tory were merged and swallowed up in the transcendent

Merge

Merge, v. t. To be sunk, swallowed up, or lost.

Native irresolution had merged in stronger motives. --I. Taylor.

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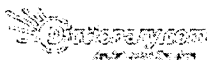
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intertwinning
Intertwiningly
Intertwist

in·ter·twine  [in-ter-twahyn] Show IPAPronunciation -verb (used with object), verb (used without object), -
twined, -twine ing.
to twine together.

Origin:

1635-45; INTER- + TWINE

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www.myawoss.com**in·ter·twine**  (in'tar-twīn') Pronunciation Key
tr. & intr. v. inter-twined, inter-twining, inter-twinesTo join or become joined by twining together.
in'ter-twine'ment *n.*The American Heritage® Dictionary of the English Language, Fourth Edition
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intertwine

verb

1. spin, wind, or twist together, "intertwine the ribbons"; "Twine the threads into a rope"; "intertwined hearts" [ant: [untwine](#)]
2. make lacework by knotting or looping [syn: [laid](#)]
3. make a loop in; "loop a rope" [syn: [loop](#)]

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Intertwine

In'ter·twine"v, v. t. To unite by twining one with another; to entangle, to interlace. --Milton.

Intertwine

In'ter·twine"v, v. i. To be twined or twisted together; to become mutually involved or enfolded.

Intertwine

In'ter·twine"v, n. The act intertwining, or the state of being intertw

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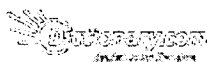


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
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


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Interwar
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Interweavement
Interweaver
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in·ter·weave  (v. in ter weev; n. in-ter-weev)

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verb, -wove or -weaved, -wo·ven or -wove or -weaved, -weav·ing,
noun

-verb (used with object)

1. to weave together, as threads, strands, branches, or roots.
2. to intermingle or combine as if by weaving: *to interweave truth with fiction.*

-verb (used without object)

3. to become woven together, interlaced, or intermingled.

-noun


4. the act of interweaving or the state of being interwoven;
blend: *a perfect interweave of Spanish and American cultures.*

Origin:

1570-80, INTER- + WEAVE

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in·ter·weave  (in'ter-wēv') [Pronunciation Key](#)

v. in'ter·wove (-wōv'), in'ter·wo·ven (-wō'vən),
inter·weav·ing, inter·weaves

v. tr.

1. To weave together.
2. To blend together; intermix.

v. intr.

To intertwine

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interweave

verb

interlace by or as if by weaving [syn: weave] [ant: unweave]

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Interweave

inˈtɪrˈweɪv, v. t. [imp. & obs. p. p. Interwove, p. p. Interwoven; p. pr. & vb. n. Interweaving]

1 To weave together; to intermix or unite in texture or construction; to intertwine; as, threads of silk and cotton interwoven.

Under the hospitable covert nigh Of trees thick interwoven. -- Milton.

2 To intermingle; to unite intimately; to connect closely; as, to interweave truth with falsehood. --Dryden.

Words interwove with sighs found out their way --Milton

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EXHIBIT F



EXHIBIT G

CITRUCEL

No Excess Gas
Durable Reinforcement
100% Shrink Free
Easy to Install

[illegible]

Columns as Offered

- Column is provided by factory
- No Column products are sold as bare shells

Columns as Offered

- Column is provided by factory
- No Column products are sold as bare shells

Specimen

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

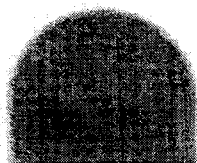
United States Patent and Trademark Office

Reg. No. 3,071,013

Registered Mar. 21, 2006

**TRADEMARK
PRINCIPAL REGISTER**

CITRUCEL



MERRELL PHARMACEUTICALS INC. (DELA-
WARE CORPORATION)
3711 KENNETT PIKE, SUITE 200
GREENVILLE, DE 19807

FOR: LAXATIVES AND DIETARY FIBER SUP-
PLEMENTS, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51
AND 52).

FIRST USE 4-7-2004; IN COMMERCE 4-7-2004.

OWNER OF U.S. REG. NOS. 1,316,519, 2,828,513
AND OTHERS.

THE COLOR(S) TEAL, ORANGE AND YELLOW
IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE WORD CITRUCEL IN TEAL, BELOW
WHICH IS AN ORANGE SEMI-OVAL WITH A
YELLOW EDGE.

SER. NO. 78-598,517, FILED 3-30-2005.

LINDA POWELL, EXAMINING ATTORNEY

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

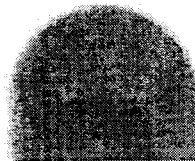
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YELLOW EDGE.

SER. NO. 78-598,517, FILED 3-30-2005.

LINDA POWELL, EXAMINING ATTORNEY



Dec 7, 2005

NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:
78/598,517
2. Mark:
CITRUCEL
and design
3. International Class(es):
5
4. Publication Date:
Dec 27, 2005
5. Applicant:
Merrell Pharmaceuticals Inc.

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

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04	19674	N/A	0	0	0:01	"260117"[dc]
05	4731	N/A	0	0	0:01	"260116"[dc]
06	77621	N/A	0	0	0:01	"260121"[dc]
07	8619	N/A	0	0	0:01	"260106"[dc]
08	3582	N/A	0	0	0:01	7 and (4 or 6)
09	1208	657	3	551	0:03	8 and "005"[cc]
10	8905	N/A	0	0	0:01	"260303"[dc]
11	11176	N/A	0	0	0:01	"260317"[dc]
12	28817	N/A	0	0	0:01	"260321"[dc]
13	3382	N/A	0	0	0:01	10 and (11 or 12)
14	1135	360	5	775	0:03	13 and "005"[cc]

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Trademark/Service Mark Application, Principal Register

Serial Number: 78598517

Filing Date: 03/30/2005

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MARK SECTION	
MARK FILE NAME	WTICRS\EXPORT11\IMAGEOUT 11\785\985\78598517.xml\1\ APP0002.JPG
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	CITRUCEL
COLOR MARK	YES
COLOR(S) CLAIMED	The color(s) teal, orange and yellow is/are claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the word CITRUCEL in teal, below which is an orange semi-oval with a yellow edge.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	397 x 449
OWNER SECTION	
NAME	Merrell Pharmaceuticals Inc.
STREET	3711 Kennett Pike, Suite 200
CITY	Greenville
STATE	Delaware
ZIP/POSTAL CODE	19807
COUNTRY	United States
AUTHORIZED EMAIL COMMUNICATION	No
LEGAL ENTITY SECTION	
TYPE	CORPORATION
STATE/COUNTRY OF INCORPORATION	Delaware
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	005
DESCRIPTION	Laxatives and dietary fiber supplements
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 04/07/2004
FIRST USE IN COMMERCE DATE	At least as early as 04/07/2004
SPECIMEN FILE NAME(S)	WTICRS\EXPORT11\IMAGEOUT 11\785\985\78598517.xml\1\ APP0003.JPG
SPECIMEN DESCRIPTION	A label for the goods listed in the application.
PRIOR REGISTRATION(S)	Applicant claims ownership of U.S. Registration Number(s) 1316519, 2316780, 2828513, and others.
SIGNATURE SECTION	
SIGNATORY FILE	WTICRS\EXPORT11\IMAGEOUT

PAYMENT SECTION

NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	325
TOTAL AMOUNT	325

ATTORNEY

NAME	Susan Upton Douglass
FIRM NAME	Fross Zelnick Lehrman & Zissu, P.C.
STREET	866 United Nations Plaza
CITY	New York
STATE	New York
ZIP/POSTAL CODE	10017
COUNTRY	United States
PHONE	(212) 813-5900
FAX	(212) 813-5901
EMAIL	sdouglass@frosszelnick.com
AUTHORIZED EMAIL COMMUNICATION	Yes
ATTORNEY DOCKET NUMBER	MERR 0503163

CORRESPONDENCE SECTION

NAME	Susan Upton Douglass
FIRM NAME	Fross Zelnick Lehrman & Zissu, P.C.
STREET	866 United Nations Plaza
CITY	New York
STATE	New York
ZIP/POSTAL CODE	10017
COUNTRY	United States
PHONE	(212) 813-5900
FAX	(212) 813-5901
EMAIL	sdouglass@frosszelnick.com
AUTHORIZED EMAIL COMMUNICATION	Yes

FILING INFORMATION

SUBMIT DATE	Wed Mar 30 17:40:33 EST 2005
TEAS STAMP	USPTO/BAS-209208142162-20 050330174033212682-785985 17-2006dbda768b39e1b18631 ce451d7b2199-DA-538-20050 330173827783521

Serial Number: 78598517

Filing Date: 03/30/2005

To the Commissioner for Trademarks:

MARK: CITRUCEL (stylized and/or with design, see mark)

The literal element of the mark consists of CITRUCEL.

The color(s) teal, orange and yellow is/are claimed as a feature of the mark.

The mark consists of the word CITRUCEL in teal, below which is an orange semi-oval with a yellow edge.

The applicant, Merrell Pharmaceuticals Inc., a corporation of Delaware, residing at 3711 Kennett Pike, Suite 200, Greenville, Delaware, United States, 19807, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

The applicant, or the applicant's related company or licensee, is using the mark in commerce, and lists below the dates of use by the applicant, or the applicant's related company, licensee, or predecessor in interest, of the mark on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.

International Class 005: Laxatives and dietary fiber supplements

In International Class 005, the mark was first used at least as early as 04/07/2004, and first used in commerce at least as early as 04/07/2004, and is now in use in such commerce. The applicant is submitting or will submit one specimen for *each class* showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) A label for the goods listed in the application..

Specimen - 1

Applicant claims ownership of U.S. Registration Number(s) 1316519, 2316780, 2828513, and others.

The applicant hereby appoints Susan Upton Douglass of Fross Zelnick Lehrman & Zissu, P.C., 866 United Nations Plaza, New York, New York, United States, 10017 to submit this application on behalf of the applicant. The attorney docket/reference number is MFERR 0503163.

The USPTO is authorized to communicate with the applicant or its representative at the following email address: sdouglass@frosszelnick.com.

A fee payment in the amount of \$325 will be submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature:

Signatory's Signature: Signature

Mailing Address:

Susan Upton Douglass
866 United Nations Plaza
New York, New York 10017

RAM Sale Number: 538

RAM Accounting Date: 03/31/2005

Serial Number: 78598517

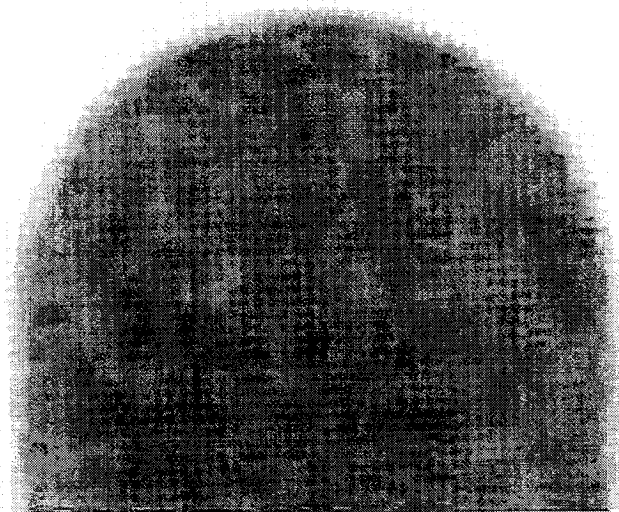
Internet Transmission Date: Wed Mar 30 17:40:33 EST 2005

TEAS Stamp: USPTO/BAS-209208142162-20050330174033212

682-78598517-2006dbda768b39e1b18631ce451

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CITRUCEL



CITRUCEL

METHYLCELLULOSE FIBER THERAPY
FOR REGULARITY

No Excess Gas
Doctor Recommended
100% Soluble Fiber
Easy to Swallow

100 FIBER CAPLETS

Uses: Helps restore and maintain regularity. Helps relieve constipation. Also useful in treatment of constipation (irregularity) associated with other bowel disorders when recommended by a physician. This product generally produces a bowel movement in 12 to 72 hours.

Directions: Adult dose: Begin with 2 caplets and may be increased up to 4 as needed with 8 ounces of liquid. Not to exceed 12 caplets per day. Two adult doses of Citrucel Caplets (4 caplets) equals one scoop of Citrucel Powder. Children (5-12 years): Take one caplet with 8 ounces of liquid up to six times per day. Not to exceed 6 caplets per day. The dosage requirement may vary according to the severity of constipation. Drinking another glass of water is helpful. Children under 5 years: consult a physician. **TAKE THIS PRODUCT (CHILD OR ADULT DOSE) WITH AT LEAST 8 OUNCES (A FULL GLASS) OF WATER OR OTHER FLUID. TAKING THIS PRODUCT WITHOUT ENOUGH LIQUID MAY CAUSE CHOKING. SEE WARNINGS.**

WARNINGS: Consult a physician before using any laxative product if you have noticed a sudden change in bowel habits which persists for two weeks. Unless directed by a physician, do not use laxative products when abdominal pain, nausea, or vomiting are present. Discontinue use and consult a physician if rectal bleeding

or failure to produce a bowel movement occurs after use of any laxative product. Unless recommended by a physician, do not exceed recommended maximum daily dose. Laxative products should not be used for a period longer than a week unless directed by a physician. If sensitive to any of the ingredients, do not use. **TAKING THIS PRODUCT WITHOUT ADEQUATE FLUID MAY CAUSE IT TO SWELL AND BLOCK YOUR THROAT OR ESOPHAGUS AND MAY CAUSE CHOKING. DO NOT TAKE THIS PRODUCT IF YOU HAVE DIFFICULTY IN SWALLOWING, IF YOU EXPERIENCE CHEST PAIN, VOMITING OR DIFFICULTY IN SWALLOWING OR BREATHING AFTER TAKING THIS PRODUCT, SEEK IMMEDIATE MEDICAL ATTENTION. KEEP THIS AND ALL DRUGS OUT OF THE REACH OF CHILDREN.**

Active ingredient: Each caplet contains 500mg Methylcellulose.

Inactive ingredients: Croscarmellose Dioxide, Calcium Phosphate, FD&C Yellow No. 6, Aluminum Lake, Magnesium Stearate, Maltodextrin, Polyethylene Glycol, Sodium Lauryl Sulfate.

Store at room temperature 15-30°C (59-86°F). Protect contents from moisture.

Citrucel is different.

• Citrucel is protected by patents.

• No Citrucel products are sold as store brands.

REMARK OFFICE:

UNITED STATES PATENT AND TRADE
MARK OFFICE APPLICATION FOR REGISTRATION OF

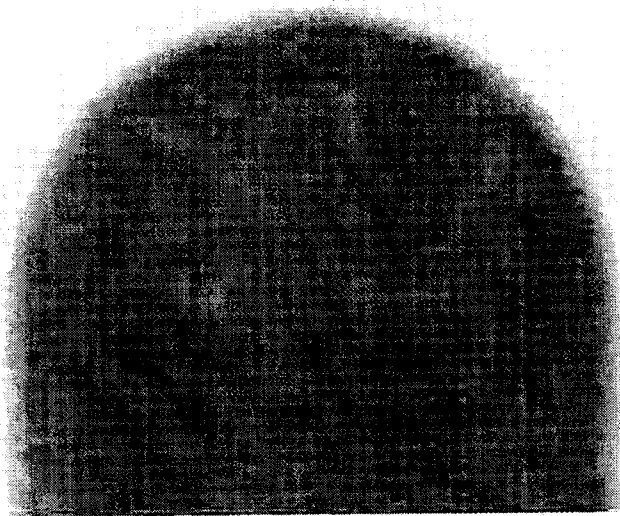
that all correspondence in connection with this application be directed
to of Fross Zehnick Lemman & Zitz, P.C., 306 United Nations Plaza, 14th
Floor, New York, New York 10017, Attention: Susan Upton DeGuerre, the law firm
of Fross Zehnick Lemman & Zitz, P.C., 306 United Nations Plaza, 14th
Floor, New York, New York 10017.

is signed and dated. The applicant certifies that it
owns the goods and services listed in this application and that the
applicant is the owner of the mark in connection with the application.
The applicant certifies that it is the owner of the mark in connection
with the application.

DECLARATION
APPROVED: 3711 Kennon Pike, Suite 200

being hereby warranted that with the exception of the mark made
by the applicant, or by its agent, or by its licensee, or by its
assignee, or by its successor in interest, or by its estate, or by its
heirs, or by its assigns, or by its executors, or by its administrators,
no other person, firm, or corporation is entitled to use the mark in
connection with the goods and services listed in this application.
The applicant certifies that it is the owner of the mark in connection
with the application.

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Doctor Recommended
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Store at room temperature 15-30°C (59-86°F). Protect contents from moisture.

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EXHIBIT H

In re Boyd Coffee Co., 25 USPQSPQ 1828 (Fed. Cir. 1988):



In re Miller Sports Inc., 51 USPQ2d 1059 (TTAB 1999):



In re San Diego National League Baseball Club, Inc., 224 USPQ 1067 (TTAB 1983):



In re Library Restaurant, Inc., 194 USPQ 446 (TTAB 1977):



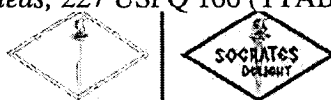
In re Alchemy Nominees Pty LTD, Serial No. 75/501,743, July 22, 2003:



In re Schechter Brothers Modular Corp., 182 USPQ 694 (TTAB 1974):



In re Sperouleas, 227 USPQ 166 (TTAB 1985):



In re Berg Electronics, Inc., 163 USPQ 487, 1969 WL 9165 (TTAB 1969):

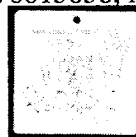


In re In Mook Kim, Serial No. 78483075, July 14, 2006:



In re Green U.O.D., Inc., Serial No. 76615858, March 31, 2008:

URBAN RENEWAL



URBAN RENEWAL & HOME

In re Pharma Cosmetix Research, L.L.C., Serial No. 76269152, October 11, 2007:

ENVIRONMENTAL PROTECTION FACTOR



THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
July 22, 2003
Paper No. 22
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alchemy Nominees Pty LTD

Serial No. 75/501,743

David G. Boutell of Flynn Thiel Boutell & Tanis, P.C. for
Alchemy Nominees Pty LTD.

Hellen M. Bryan-Johnson, Trademark Examining Attorney, Law
Office 114 (K. Margaret Le, Managing Attorney).

Before Hairston, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

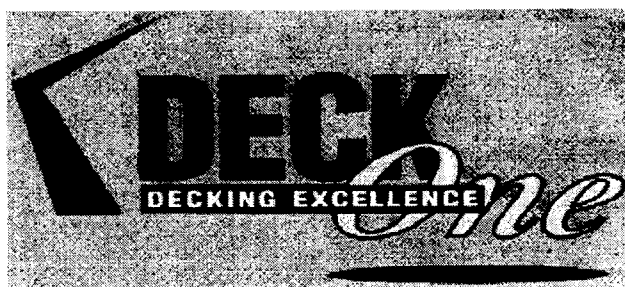
Alchemy Nominees Pty LTD seeks registration on the
Principal Register for the mark shown below:



as used in connection with goods identified, as amended, as
"metal building products, namely, nails, screws, bolts, metal

strapping, and fasteners for holding decking planks to a timber joist," in International Class 6.¹

This case is now before the Board on appeal from the final refusal to register on the ground that the specimen of record does not show use of the mark as it appears in the drawing. The composite mark is printed several different places on the specimen, and each time it includes the additional wording "Decking Excellence" in a rectangle superimposed over the initial portion of the word ONE, as follows:



The Trademark Examining Attorney essentially contends that this new composite form, as it appears on the specimen, creates a separate commercial impression from that presented in applicant's drawing. According to the Trademark Examining

¹ Application Serial No. 75/501,743 was filed on June 15, 1998, based upon applicant's claim of a *bona fide* intention to use the mark in commerce. Following the United States Patent and Trademark Office's issuance of a Notice of Allowance, applicant timely filed its Statement of Use under Trademark Rule 2.88, claiming use of this mark anywhere at least as early as January 31, 1999 and use in commerce at least as early as March 25, 1999, and including the required specimen.

Attorney, this is true because of the way the additional words DECKING EXCELLENCE are placed prominently in the foreground of the mark, partially obscuring and thereby diminishing the relative significance of the word "ONE."

By contrast, applicant argues that as shown on its specimen, the term "DECKING EXCELLENCE represents non-distinctive unregistrable matter," and that this laudatory slogan appears in small print, and it is placed inside a box. As a result, applicant argues that it is totally separate from the stylized DECK ONE lettering and does not change the commercial impression of the DECK ONE mark as shown in its drawing.

Applicant has argued that a new specimen is not required and has indicated no interest in amending the mark as shown in the drawing. Hence, the sole question before the Board in this appeal is whether or not the specimen submitted with the Statement of Use in this Intent-to-Use application actually supports registration of the applied-for mark.

After careful consideration of the record before us in this appeal, including the arguments of applicant and the Trademark Examining Attorney, we hold that the requirement for a substitute specimen is not justified in light of the relatively minor alteration involved herein.

We begin our analysis with the language of Trademark

Rule 2.51(a)(2):

"In an application under §1(b) of the Act, the drawing of the trademark shall be a substantially exact representation of the mark as intended to be used on or in connection with the goods specified in the application, and once ... a statement of use under §2.88 has been filed, the drawing of the trademark shall be a *substantially exact representation* of the mark as used on or in connection with the goods."

We note that Rule 2.51(a)(1) as it applies to use-based applications and Rule 2.51(a)(2) as it applies to intent-to-use-based applications are essentially the same. Most published Board decisions dealing with the "substantially exact representation" standard involve the owner of a mark filing a use-based application who has consciously culled out for registration just a portion of a larger composite mark. By contrast, in the instant case, it appears that sometime between the time this intent-to-use application was filed in June 1998 and the time the mark was first used in January 1999, applicant added the DECKING EXCELLENCE element. Nonetheless, these reported decisions are relevant because the test is the same whether the owner of a mark already in use has pulled out for registration a portion of a composite mark or the owner of an ITU application has added additional matter between the time of filing the trademark application and eventually making commercial usage.

Actually, there appears to be agreement between applicant and the Trademark Examining Attorney with the long-standing principle that an applicant may apply to register any element of a composite mark displayed on the specimen of use, *provided* that applied-for element, in and of itself, presents a separate and distinct commercial impression as a mark. See Institut National des Appellations D'Origine v. Vintners International Co., Inc., 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992); In re Raychem Corp., 12 USPQ2d 1399 (TTAB 1989); In re Lear-Seigler, Inc., 190 USPQ 317 (TTAB 1976); and In re Berg Electronics, Inc., 163 USPQ 487 (TTAB 1969).²

As stated by the Court of Appeals for the Federal Circuit in the case of Institut National, *supra* at 1197:

'Mutilation' is a concept long recognized as a part of trademark registration case law. In re Servel, Inc., 181 F.2d 192, 85 USPQ 257,

² See also Trademark Manual of Examining Procedure (TMEP) §807.14(b), (Third Edition 2002):

[I]n an application under §1 of the Trademark Act, the applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark used or intended to be used if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s)...

259-60 (CCPA 1950). The issue must be decided on the facts of each case.

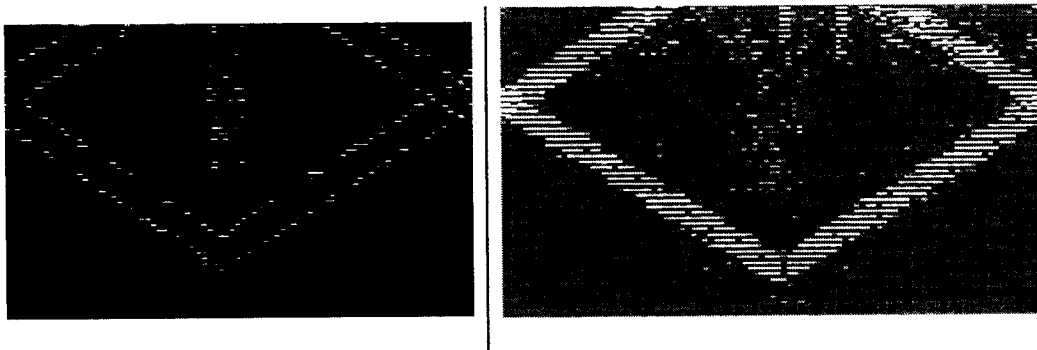
And later in the Institut National case, the Court cited Professor J. Thomas McCarthy's treatise³ saying that the question is "what exactly is the 'trademark'?" and further quoted Professor McCarthy as follows:

It all boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct "trademark" in and of itself.

Based largely upon the spatial and physical relationship of the elements herein, the Trademark Examining Attorney variously describes the new wording element on the specimen as being "merged," "intertwined" or "interwoven" with DECK ONE. In her judgment, the new wording is "integrated" with the balance of the specimen image, thereby making it an "essential" part of the composite mark. She notes that the additional words " ... are inside a rectangular carrier and superimposed over a significant part of the word ONE. Therefore, the specimens show a well-integrated mark in which the individual elements cannot be separated without mutilating the mark." (Examining Attorney's appeal brief, p. 3).

³ The current citation in McCarthy's treatise on this subject is 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §19:59 (4th ed. 2001).

In support of her position, the Trademark Examining Attorney cites to In re Sperouleas, 227 USPQ 166 (TTAB 1985), where the Board found that the design could not be registered apart from the wording. Images of the drawing and usage on the Sperouleas specimens follow:



The Board's finding of mutilation in the Sperouleas case is premised on the fact that within a composite where literal elements are prominent and placed over top of rather commonplace design features, the design feature may not be lifted out for separate registration. Conversely, the Board in Sperouleas stated:

" ... [T]he words in this case may be lifted from the design and separately registered, since as aforementioned they form the dominant part of the mark and since they are not obliterated by any part of the design ..."

Sperouleas *supra* at 168. The Board implied that it would not have found mutilation if applicant had applied to register the special form presentation of SOCRATES DELIGHT within the diamond design, but without the torch design. Thus, this hypothetical culling is closer to the facts of the instant

case than was Sperouleas' actual attempt to register the torch and diamond design without the wording.

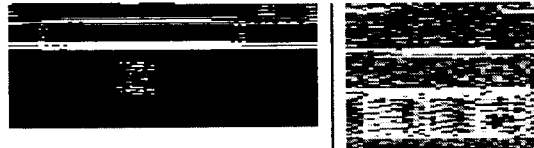
In this case, we acknowledge that the spatial placement and overlapping physical relationship of the wording "Decking Excellence" (i.e., underlining the word "Deck" and covering up a portion of the word "One") create some degree of physical connectedness between the literal elements of the composite shown on the specimen. On the other hand, we do not agree with the Trademark Examining Attorney that the wording "Decking Excellence" is an inseparable element of the entire mark as shown on the specimens. Rather, we find that visually the laudatory term "Decking Excellence" comprises an incidental overlay. As to connotation, the wording "Decking Excellence" merely accentuates the "preeminent" connotation of "Deck One." Finally, the unique design of the critical components of the mark remain unchanged between these two presentations, leaving the overall commercial impression of the DECK ONE mark unchanged with this addition:



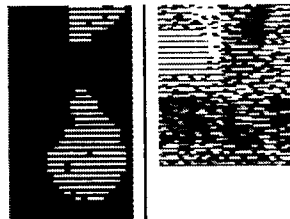
In order to better calibrate our analysis, we review a number of reported trademark registration decisions where

applied-for elements were indeed found to be inextricably bound together with other design features within their respective composite marks, and hence could not be extracted. These decisions are helpful to our analysis inasmuch as the explanations all involve more than merely some degree of touching between (or among) the elements shown on the specimens in question. For example, prominently placed, arbitrary wording generally cannot be deleted. An element cannot be culled if it appears to be interacting in some manner with other elements in the composite as shown on the specimen. Similarly, the mutilation concept prohibits the removal of critical elements if their removal would change the overall look and feel of the mark.⁴ Each of the half-

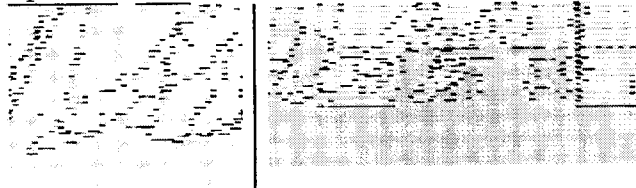
⁴ In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993),



In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988),



In re Miller Sports Inc., 51 USPQ2d 1059 (TTAB 1999),



dozen cases cited above (where the applied-for matter differs from the composite image as actually used) presents an excellent visual example of the respective applicant's mutilation of a mark's commercial impression.

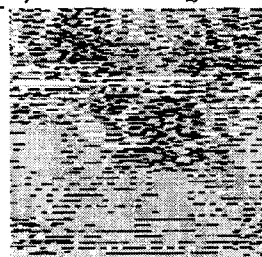
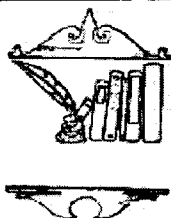
However, none of these basic fact patterns is present herein. When comparing the drawing of the mark (i.e., the matter for which applicant is seeking registration) with the composite mark as shown on the specimen, applicant has not pulled out a design feature for registration; applicant has not deleted arbitrary matter; applicant has not culled out some words from among other words of the same or similar size located together on the same line; and applicant has not changed the overall look and feel of the mark. Rather, the matter that applicant herein has attempted to pull out for

In re San Diego National League Baseball Club, Inc., 224 USPQ 1067 (TTAB 1983) [overturned on separate issue of mere descriptiveness of publications (In Re WNBA Enterprises, LLC, ___ USPQ2d ___, Serial No. 75/599,525 (TTAB June 11, 2003))]:

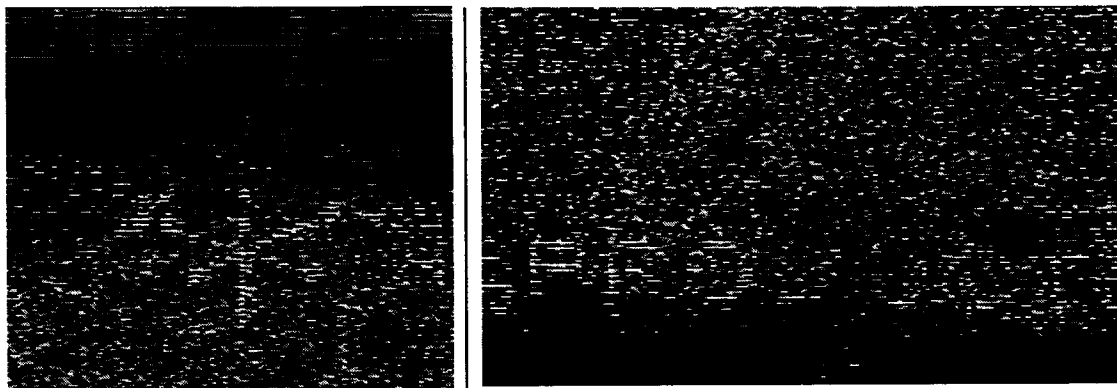
PADRES REPORT



In re Library Restaurant, Inc., 194 USPQ 446 (TTAB 1977),



registration comprises the only source-indicating material shown in the composite on the specimens as ultimately used. Accordingly, we find that the instant case is more like that of Schechter Bros. Modular Corp., 182 USPQ 694 (TTAB 1974):



The Board reversed the Examining Attorney, permitting applicant to cull out the primary wording and part of the design, and explained its reasoning as follows:

It is applicant's position that the subject matter of the application does not in any way destroy the commercial impression engendered by the total composite mark shown in its specimens. Applicant submits that the impression created by the mark as shown in its specimens is essentially what it is attempting to register in that the omission of the shadow image of the word portion does not obliterate or destroy the mark.

We agree with applicant. The shadow image is in effect a redundancy - it makes for an interesting logo but it is the word portion of the mark that creates the essential impression in this particular instance. And, purchasers of the goods are not likely to repeat that word mark or be impressed thereby only if it is repeated in the shadow image form.

The fact that applicant is the owner of a registration for "RAINAIRE," simpliciter, is indicative of what applicant basically considers its mark to be. In our opinion, the deletion of the shadow image is but a minor alteration and does not create a new and different mark creating a different commercial impression. It is our opinion that what is sought to be registered and the matter shown in the specimens are basically the same marks creating the same impressions. Applicant is not obligated to file a new drawing or new specimens.

As noted earlier, this case presents us with a factual judgment as to whether the designation for which registration is sought is a separate and distinct trademark. We find that applicant's mark as shown on the drawing is a substantially exact representation of the mark shown on the specimen of record because the DECK ONE and design mark shown in the drawing makes a separate and distinct commercial impression - with or without the largely incidental element added to this design, as shown on the specimen.

Decision: The refusal to register based upon a requirement for an acceptable, substitute specimen is reversed.

EXHIBIT I

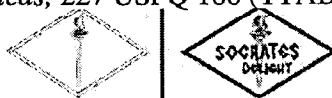
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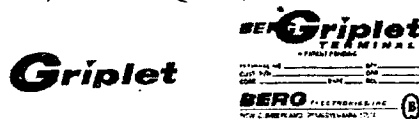
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In re In Mook Kim, Serial No. 78483075, July 14, 2006:



In re Green U.O.D., Inc., Serial No. 76615858, March 31, 2008:

URBAN RENEWAL



URBAN RENEWAL HOME

In re Pharma Cosmetix Research, L.L.C., Serial No. 76269152, October 11, 2007:

ENVIRONMENTAL PROTECTION FACTOR



In re Royal Bodycare, Inc., ___ USPQ2d ___, Serial No. 78976265 (TTAB Feb. 22, 2007):



NANOCEUTICAL